

No. 11,667.

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

TODD C. FAULKNER,

Appellant,

vs.

JOHN T. GIBBS,

Appellee.

BRIEF FOR APPELLANT.

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BRIEF FOR APPELLANT.

Jurisdictional Statement.

This is a suit for infringement of United States Letters Patent and the District Court of the United States for the Southern District of California, Central Division had jurisdiction under 28 U.S.C.A. 109. An interlocutory decree finding infringement of certain of the claims in suit having been entered in said District Court, this Court of Appeals has jurisdiction under 28 U.S.C.A. 225 and 227.

The First Amended Complaint filed in the District Court is reproduced on pages 2, 3 and 4 of the Record, and the First Amended Answer of Defendant appears on pages 8-14, incl., of the Record, said Answer including a Counterclaim as set forth on pages 12 and 13 of the Record. Plaintiff's reply to said Counterclaim appears on pages 18 and 19 of the Record.

Statement of the Case.

The patent in suit No. 1,906,260, was issued to the Plaintiff, John T. Gibbs, on May 2nd, 1933, on a patent application filed by him on February 16, 1931.

The patent discloses and claims an electrified version of the well-known games variously called Bingo, Keeno or Tango [R. 100, 171]. These games, hereinafter usually referred to as Bingo games, were an outgrowth of the old game of Lotto [R. 231] and were played by a number of competing players each provided with a card having five rows of five numbered squares thereon. A large basket or box having a plurality of numbered open compartments therein was disposed in back of the counter before which the players sat. Each player in rotation had a chance to throw a ball into the basket and the number of the pocket into which the ball fell was called out by the operator. Each player then placed a marker on his card in the square bearing the number called. The first player to get five markers in a line, either horizontally, vertically or diagonally was declared the winner [R. 69, 70, 232].

The Gibbs game of the patent in suit comprises a plurality of electrically interconnected game units, operated by separate players who compete with each other. Each unit has a playing board with five rows of five holes therein, and an annunciator backboard with five rows of five indicator lights. Each light is connected to a switch under a corresponding hole in the playing board and when a ball goes through one of said holes after being rolled across the board by the player the indicator light corresponding to that hole is energized and remains illuminated during the play. The first player to light up five of said

indicator lights in a row, either horizontally, vertically or diagonally is declared the winner.

When the ball goes through the fifth hole in a line, a win circuit is completed which lights a win light on top of the annunciator panel of the winning game, rings a bell to notify the operator and players of the win, and simultaneously disconnects the competing game units to prevent the other players from continuing the play and possibly claiming a tie game. [See Alternate Proposed Finding XVII, R. 24, and patent in suit, R. 303].

The Plaintiff has enjoyed a lucrative business in licensing his games to amusement parks throughout the country. From time to time alleged infringers have appeared and been sued by Plaintiff, and in most of the cases, consent decrees were taken and the Defendants given a license by the Plaintiff to continue operation of their games. One Defendant, the T.Z.R. Amusement Corporation in New York who, the evidence showed had clearly and deliberately copied Plaintiff's game in practically all of its details, contested Plaintiff's suit and lost the decision in the District Court (*Gibbs, et al. v. T.Z.R. Amusement Corp., et al.*, 14 Fed. Supp. 957), the decision and findings of fact of said suit comprising Plaintiff's Exhibit No. 3 [R. 346].

About two years prior to the commencement of this suit the Defendant Todd C. Faulkner built and operated an electro-mechanical Bingo game on the Pike in Long Beach, California, under the name of "FAWN." The outward appearance and method of play of the Fawn game were similar to some electrified Bingo games then being operated on the Pike as Lite-A-Line by Arthur Loeff and

Douglas Wiser, partners doing business as "Skill Games" which were in turn somewhat similar in outward appearance and method of play to the Gibbs game.

Early in 1946 Gibbs sued Looft and Wiser for infringement of the patent here in suit and on August 27, 1946 said case was settled by the entry of a consent judgment [R. 355] and the granting of a license to Looft and Wiser for the City of Long Beach. Immediately thereafter Plaintiff started suit No. 5565-W against C. M. Hicks, *et al.*, doing business on the Pike as "Skill-A-Line" and against this Defendant, Todd C. Faulkner, No. 5566-Y, doing business on the Pike as the Fawn Game. The Defendants Hicks *et al.*, shortly thereafter stipulated to a consent decree for Plaintiff and went out of business. The Defendant Faulkner elected to stand and fight.

An Amended Complaint [R. 2] was filed on August 29, 1946 naming the Appellant, Todd C. Faulkner, and his wife, Edna D. Faulkner, as joint Defendants. At the trial said Complaint was dismissed as to Edna D. Faulkner.

On October 9, 1946 Plaintiff moved for a preliminary injunction and in support of said motion filed a description of the charged Fawn games and their mode of operation [R. 309]. Said motion was not contested and on November 12, 1946 an order for a preliminary injunction was issued by Judge Yankwich pursuant to which a writ of preliminary injunction was issued out of the District Court.

In the meantime Defendant had changed the construction, electrical circuits and method of play of his accused Fawn game, making it a non-competitive game in which the various players played against a clock instead of against each other and consequently there might be several winners instead of merely one as before. This modified or altered game is now being operated by Defendant and will herein be referred to as the "New Fawn Game."

The Defendant made a full disclosure to Plaintiff's counsel of his new Fawn game and requested Plaintiff to include it in this suit if Plaintiff thought that it infringed his patent. This the Plaintiff declined to do, either by contempt proceedings or by Amended Complaint, and consequently on January 7, 1947, Defendant filed Interrogatories [R. 5] to compel Plaintiff to state whether or not he charged the new Fawn game to be an infringement of his said patent.

Plaintiff objected to said Interrogatories, but was required by the Court to answer Nos. 1, 2 and 3 thereof. Therefore Defendant filed his First Amended Answer [R. 8] which included a Counterclaim [R. 12] alleging a controversy between the parties concerning the new Fawn game and praying for a declaratory judgment of non-infringement of *both* Fawn games and *invalidity* of the Gibbs' patent.

Subsequent to the filing of said Amended Answer Plaintiff filed his answers to said Interrogatories [R. 15] in which he charged said new game to infringe, and on

the day of trial Plaintiff filed his reply to Defendant's Counterclaim denying all of the essential allegations thereof.

Said case was tried on both issues, to-wit: (1) the alleged infringement of the old competitive Fawn game, and (2) the alleged infringement of the new *non*-competitive Fawn game. Following the trial of these issues oral argument was had, during the latter portion of which there was an extended colloquy between the Court and counsel for Plaintiff [R. 258-281] and the Court gave its decision orally from the bench [R. 282-289].

The trial court first held that the old game infringed all the claims in suit and that the new Fawn game infringed claims 3, 7, 8, 9 and 10, but not claim 6 because it was a non-competitive game [R. 287]. Upon the attention of the Court being called to the fact that claims 7 and 8 were dependent upon claim 6 and therefore could not possibly be infringed since parent claim 6 was not infringed, the Court modified its holding and ruled that only claims 3, 9 and 10 were infringed by the new Fawn game [R. 288, 289]. Defendant then pointed out to the Court that claims 9 and 10 were narrower versions of broad claim 6 and therefore, like 7 and 8 could not possibly be infringed, but the Court declined to further modify its ruling.

The Plaintiff presented a set of generalized Findings of Fact and Conclusions of Law [R. 33-40] and the Defendant presented Alternate Findings and Conclusions [R.

20] which were thought to more accurately conform to the statements made by the trial court in its discussion with counsel and in its oral decision from the bench. However, the Court rejected all of Defendant's Alternate Findings and signed without change the Findings of Fact and Conclusions of Law submitted by Plaintiff and also the Interlocutory Judgment [R. 41] submitted by Plaintiff, which Judgment was entered on March 31, 1947.

This appeal is prosecuted from said Interlocutory Judgment and raises three principal issues as follows:

- (1) Is the Gibbs patent valid?
- (2) Does the new Fawn game infringe the Gibbs patent?
- (3) Did the old Fawn game infringe said patent?

These major issues are of course subdivided into minor issues as detailed in the Assignment of Errors and Argument hereinafter set forth.

At this point however, it is desired to call this Court's particular attention to the *most* glaring of the trial court's many errors, to-wit: that of holding narrow claims 9 and 10 infringed by the new Fawn game when broad claim 6 directed to exactly the same subject matter was held *not* infringed by the new game.

An equally basic error was made by the trial court in holding claim 3 infringed by the new Fawn game when obviously one of the essential elements of claim 3 is totally lacking in said game.

Specification of Errors.

In Appellant's statement of points upon which Defendant-Appellant intends to rely on appeal [R. 48] the various errors of the trial court are individually set forth. Here, in accordance with Rule 20 we have grouped the errors in accordance with the issues involved and related them to the Findings of Fact and Conclusions of Law on file herein.

AS TO THE ISSUE OF VALIDITY:

1. The Court erred in holding the claims in suit valid and that the public in general has acquiesced in said validity [Appeal Points 1 and 6, R. 48; Findings IV, VII, VIII, IX, X and XIV, R. 34-38].
2. The Court erred in not finding claims 3, 6, 7 and 8 of the Gibbs patent invalid for lack of novelty [Appeal Point 12, R. 49; Findings X and XIV, R. 36, 39].
3. The Court erred in not holding claims 9 and 10 invalid for ambiguity, indefiniteness, and failure to particularly point out and distinctly claim the alleged invention [Appeal Points 7 and 14, R. 48, 49; Finding VIII, R. 35].
4. The Court erred in not finding all of the claims in suit invalid for lack of invention [Appeal Point 13, R. 49; Findings X and XIV, R. 36, 38].

AS TO THE ISSUES OF INFRINGEMENT:

5. The Court erred in holding that the new Fawn game infringed claims 3, 9 and 10 of the patent in suit [Appeal Points 3 and 15, R. 48, 50; Findings XII and XIV, R. 37, 38].

6. The Court erred in holding that the new Fawn game has the same physical structure, functions, appearance and circuits, with allegedly minor exceptions, as the old Fawn game [Appeal Points 9 and 10, R. 48; Finding XII, R. 37].
7. The Court erred in holding all of the claims in suit infringed by the old Fawn game [Appeal Points 2 and 15, R. 48, 50; Findings XII and XIV, R. 38].
8. The Court erred in not following the general rule of law that the omission of an element of a patent claim avoids infringement of that claim [Appeal Point 17, R. 50; Findings XII and XIV, R. 37, 38].

AS TO ALL ISSUES:

9. The Court erred in its interpretation of the evidence, particularly the prior art, and in applying a narrow construction to the claims when considering the issue of validity, and a broad construction to said claims when considering the issue of infringement [Appeal Point 16, R. 50; Findings X, XII and XIV, R. 36-38].
10. The Court erred in not adopting the Alternate Findings of Fact and Conclusions of Law presented by Defendant which were more in consonance with the Court's oral opinion than were the Findings submitted by Plaintiff and adopted by the Court [Appeal Point 18, R. 50; Alternate Findings of Fact and Conclusions of Law, R. 20-32].

11. The Court erred in holding that the Plaintiff was entitled to an injunction, accounting, costs of suit and reasonable attorney's fees and in dismissing Defendant's Counterclaim with prejudice [Appeal Points 4 and 5, R. 48; Conclusion 4, R. 40].
12. The Court erred in holding that the Defendant derived his Fawn game from a game operated by Arthur Looff and that said Looff game had been copied from a game embodying the subject matter of the Gibbs patent [Appeal Point 11, R. 49; Finding XIII, R. 38].

Summary of Argument.

In addition to the usual issues of novelty and infringement present in all patent cases, the decree in this case presents a point that seldom appears on appeal, to-wit, the anomalous situation of a Decree holding non-infringement of a broad claim of the patent, but infringement of narrow claims thereof directed to the same subject matter covered in the broad claim. Such a holding is of course inconsistent on its face.

Appellant also finds it necessary to urge on this Appeal the correctness of the elementary rule of patent law, that omission of an element of a claim avoids infringement of that claim. This rule is usually not disputed. (See Appendix, Law Point 5.)

The failure of the trial court to follow the above-mentioned basic rules of patent law is the only reason for the Defendant's new Fawn game being involved in this Appeal.

The first error above-mentioned was committed by the trial court when, after holding broad claim 6 of the Gibbs

patent not infringed by the new Fawn game, it held narrow claims 9 and 10 directed to the same subject matter to be infringed. The exact element of claim 6 which the court found lacking in the new Fawn game is also present in claims 9 and 10. The second error above-mentioned was committed when the trial court in holding claim 3 to be infringed by the new Fawn game utterly ignored the fact that the last element of claim 3 is totally lacking in said new Fawn game.

Appellant has been sorely tempted to treat the above issues first in his brief since they are so easily disposed of, but a more logical presentation of the entire case requires that we first consider validity so that the Court will be fully apprised of the scope, if any, of Plaintiff's Patent, and then treat the issues of infringement. It is on this basis that our argument is arranged.

It is worthy of note at this point that the Findings of Fact presented by the Plaintiff and signed by the trial court without change, lay no foundation whatsoever for that portion of the Decree which finds infringement of claims 3, 9 and 10 by the new Fawn game. Likewise, there is nothing in the Court's opinion or in the Court's extended discussion with counsel for Plaintiff at the close of Plaintiff's argument to indicate the reasoning followed by the Court in arriving at its decision. For this reason we have collected and annotated in the Appendix a list of all of the statements of the trial court during the trial which may throw some light on the above rulings.

I. The Issue of Validity.

This issue may logically be divided into two parts comprising first a consideration of claim 3 which is a sub-combination claim directed to one of the individual game units disclosed in the Gibbs patent, and second, a consideration of claims 6-10, incl. which are directed to the entire game comprising a plurality of the individual units defined in claim 3 electrically interconnected.

CLAIM 3 IS INVALID.

Claim 3 by its terms broadly claims the combination of elements which go to make up one of the Gibbs individual game units, the claim making generous use of the broad and unqualified term "means." When this claim is given its literal interpretation as was done by the trial court it reads squarely on the prior art patent to Nakashima [R. 375] and is consequently invalid.

Claim 3 is additionally invalid for lack of invention over the other prior art patents which show board and ball games with annunciator lights, in view of the win signal shown by Nakashima and the prior art patents directed to multi-unit competitive games, all of which employed win signals similar to that used by Gibbs and called for in claim 3. In view of the state of the art at the time Gibbs entered the field, it was not invention to add to any one of the board and ball game patents a win signal as shown by any of the multi-unit game patents and by Nakashima.

CLAIMS 6-10, INCL., ARE INVALID.

Of this group of claims, claim 6 is the broadest and in fact is so broad as to read squarely on the prior patent to Prina [R. 479]. Consequently, claim 6, and claim 7, which merely adds thereto a win signal as shown by Prina, are both invalid for lack of novelty. Claim 8 which adds to claim 7 the manually operated main power switch inherent in the Prina structure is therefore likewise invalid.

Claims 6-10 are also invalid for lack of invention since they merely recite the interconnection of a plurality of the Nakashima-type board and ball games in the old and well-known manner shown by the multi-unit game prior art patents to Prina, Chester, Higuchi, Wallace and Irsch. Gibbs contributed nothing to the art that was not previously known, since in the construction of his individual game units he merely followed the teaching of Nakashima and the other board and ball game patentees, and then hooked up his game units as taught by Prina, Chester and others, to make an electrified Bingo game.

The narrow claims in the Gibbs patent which were not sued on by the Plaintiff perhaps display invention, since they are directed to the particular operative parts employed by Gibbs in his Bingo game. However, the claims in suit are couched in such broad language that they are clearly invalid for lack of invention.

Claim 9 and its dependent claim 10 are invalid on the additional ground of failing to particularly define the invention since they claim an invention other than the one disclosed in the Gibbs patent. We can of course make a fairly good guess as to what the Plaintiff meant to cover in claim 9, but the fact remains that he did not

so cover it and the claim is invalid therefor. It is axiomatic that the public is entitled to know and to be informed by the patent claims exactly what monopoly has been granted to the patentee so that the members of the public may guide themselves accordingly in avoiding infringement of said patent.

Although this obvious defect in claims 9 and 10 was presented to the trial court, it was not alluded to by the Court in its discussion, findings or opinion. This failure of the trial court to recognize that claim 9 clearly reads on an invention other than the one described in the Gibbs patent is thought to be obvious error.

II. The Issues of Infringement.

The old Fawn game upon which this suit was brought was a competitive game of the general type shown in the Gibbs patent in which a number of individual game units are arranged in a row and the individual players thereof compete against each other. When a player has made a win the games are all shut down and there can be no more winners. To this extent the old Fawn game was the same as the Gibbs game. It differed, however, from the Gibbs game in its internal construction.

The new Fawn game which was forcibly injected into this case by the Defendant changed the whole theory of play of the old game so that it was no longer competitive. Each player instead of playing against the other players now plays against a time clock. Consequently, there can be a number of winners or no winners within the allotted time set for the play. The trial court recognized this change as basic and consequently held claims 6, 7 and 8 not infringed by the new Fawn game.

THE NEW FAWN GAME DOES NOT INFRINGE.

Claim 9, to the extent that it is intelligible, is clearly a narrow version of claim 6, and calls for

“means controlled by the closing of the signal circuit of the winning unit for discontinuing the signals and opening the circuits of all the indicators on all of the units.”

The presence of this same element in claim 6 was what caused the trial court to find claim 6 not infringed by the new Fawn game. Obviously, if claim 6 is not infringed by the Defendant's omission of the above-quoted element, then the omission of the same element in claim 9 must avoid infringement of claim 9.

Claim 10 being dependent upon claim 9 is of course

Claim 3 is clearly *not* infringed by the new Fawn game, since the last element (h) of claim 3 is totally lacking. This element (h) reads as follows:

“supplementary means for indicating a winning play when all of the indicators in one of said groups have been energized.”

This *means* in the Gibbs game is either his win lamp L or his win bell 69. Since the new Fawn game does *not* have a win lamp or a win bell or any other “means for indicating a winning play when all of the indicators in one of said groups have been energized,” claim 3 on its face cannot be infringed.

The new Fawn game additionally avoids claim 3 since it has no means in addition to the indicator lamp switches for energizing the indicator lamps or maintaining them energized. In other words, the new Fawn game does not have the relays R of the Gibbs patent or any equivalent thereof.

so cover it and the claim is invalid therefor. It is axiomatic that the public is entitled to know and to be informed by the patent claims exactly what monopoly has been granted to the patentee so that the members of the public may guide themselves accordingly in avoiding infringement of said patent.

Although this obvious defect in claims 9 and 10 was presented to the trial court, it was not alluded to by the Court in its discussion, findings or opinion. This failure of the trial court to recognize that claim 9 clearly reads on an invention other than the one described in the Gibbs patent is thought to be obvious error.

II. The Issues of Infringement.

The old Fawn game upon which this suit was brought

THE NEW FAWN GAME DOES NOT INFRINGE.

Claim 9, to the extent that it is intelligible, is clearly a narrow version of claim 6, and calls for

“means controlled by the closing of the signal circuit of the winning unit for discontinuing the signals and opening the circuits of all the indicators on all of the units.”

The presence of this same element in claim 6 was what caused the trial court to find claim 6 not infringed by the new Fawn game. Obviously, if claim 6 is not infringed by the Defendant's omission of the above-quoted element, then the omission of the same element in claim 9 must avoid infringement of claim 9.

Claim 10 being dependent upon claim 9 is of course not infringed for the same reason as claim 9. In addition, claim 10 is clearly not infringed because it adds to the combination of claim 9 an

“audible signal commonly connected to all of said units, etc.”

which is totally lacking in either the new or old Fawn game. A simple reading of claim 10 shows this to be the fact.

THE OLD FAWN GAME DOES NOT INFRINGE.

If claim 3 is given a literal construction as it was by the trial court, it is not infringed by the old Fawn game since claim 3 calls for means in addition to the individual lamp switches for energizing the lamps of the annunciator. For this purpose Gibbs provided a relay for each indicator lamp. The Defendant, on the other hand, by

using a gravity switch which remains closed obviated the necessity for supplemental means as shown in the Gibbs patent and included in claim 3.

Claim 6 when construed as claiming a plurality of the game units defined in claim 3 is not infringed by the old Fawn game. Claim 7 is dependent upon claim 6 and is therefore not infringed for the same reasons. Claim 8 adds to claim 7 a main power switch manually operable by the operator at all times which is missing in the Fawn games.

Claim 9 as written is clearly not infringed by the old Fawn game since it very obviously describes a type of game different from either the Gibbs game or the Fawn game. Claim 10, being dependent upon claim 9 is of course avoided for the same reasons as claim 9 and additionally because the Defendant never employed an audible win signal in either of his Fawn games. It is difficult to see how claims 9 and 10 could be held infringed by either of the Fawn games.

THE QUESTION OF DERIVATION:

Although the matter of derivation of Defendant's game should not be an issue in this case, testimony was admitted by the Court by which Plaintiff attempted to show that (a) the Defendant copied the Loeff game; (b) that the Loeff game was copied from a Gibbs game, and therefore (c) that Defendant's game was a copy of the Gibbs game.

In the first place, the testimony fell far short of proving any of the above contentions, although the trial court seemed to think otherwise.

In the second place, the matter of derivation has nothing to do with the matter of infringement since it is a well

settled principle that any member of the general public has a perfect right to observe a patented device in operation and then to build and use a device of the same type so long as he does not come within the scope of the patent claims and does not violate a confidential relationship. To hold otherwise is to ignore the very basis of all patent law. However, the trial court went even further in this case and ruled that in determining the issue of infringement, weight should be given to the fact that the Defendant had looked at a device built by A, who had previously looked at a patented device of B, neither party seeing the operative mechanism of the former device.

There was absolutely no showing whatsoever of any breach of confidential relationship or of any use by Defendant of any trade secrets of Plaintiff or of information not available to the public at large. As a matter of fact, the evidence clearly showed that Defendant had no contact whatsoever with Mr. Gibbs, his patent or his games prior to the commencement of this lawsuit.

SUMMARY:

To recapitulate, it is Appellant's contention that:

- (1) Claims 3, 6, 7 and 8 are invalid for lack of novelty.
- (2) All of the claims in suit are invalid for lack of invention.
- (3) Claims 9 and 10 are additionally invalid for ambiguity and as claiming an invention not disclosed in the Gibbs patent.
- (4) None of the claims is infringed by the new Fawn game.
- (5) None of the claims is infringed by the old Fawn game.

ARGUMENT.

I.

The Issue of Validity.

A. THE DISCLOSURE OF THE PATENT IN SUIT.

The Gibbs game comprises a number of game units, each including a board C having 25 holes therein arranged in longitudinal and lateral rows, through each of which a ball B rolled over the board by a player may pass and be returned to the player. The annunciator panel A on each game board has 25 indicator lamps arranged in vertical and horizontal rows. The ball in passing down through any hole momentarily closes a pair of contacts to light the indicator lamp corresponding to that particular hole. Each indicator lamp and switch S has associated with it a relay R which operates to maintain its lamp circuit energized. Each relay R when energized closes through the medium of its armature R' a pair of contacts in series circuit relation with the contacts of other relays R associated with lamps in the same horizontal, vertical and diagonal group so that when five indicator lamps comprising either a horizontal, vertical or diagonal line are energized, the relays for the lamps in that group will complete a "win" circuit.

The power to the indicator lamps for each of the units extends through the contacts of a "feed" relay R2 and each unit is also provided with a "win" or holding relay R3 which is energized by the completion of any "win" circuit in that unit. The holding relay R3 when energized, simultaneously performs the following functions:

- (a) Energizes a supplementary signal lamp L on top of the annunciator panel of the winning unit;
- (b) Energizes an audible signal circuit to ring bell 69 to notify all of the players that one of the units has won;
- (c) Energizes the feed relay R2 of the winning unit to break its normal power circuit to the indicator lamps;
- (d) Completes an auxiliary power circuit to the indicator lamps on the winning unit to maintain them lighted; and
- (e) Energizes the feed relays R2 of all other game units, thereby immediately de-energizing them and stopping the game.

To re-start the Gibbs game the operator momentarily opens a main power switch to de-energize the “win” relay on the winning unit, and the players may then start the play. (For a detailed description of the Gibbs game, see Appendix, p. 1.)

B. CLAIM 3 IS INVALID.

As previously mentioned, claim 3 is a sub-combination claim covering one of the individual units employed in the Gibbs game. This claim is so broadly drawn as to be clearly invalid, and as an aid to the Court in considering the claim it is outlined in the following analysis which includes with each element the number of the corresponding part in the Gibbs drawings.

1. ANALYSIS OF CLAIM 3:

A game apparatus comprising

- (a) a board (C),
- (b) a plurality of contact devices therein (switches S, 53-54),
 - (1) adapted to be engaged by an object (ball B) moved over the board by a player,
- (c) a plurality of indicators (lamps 1-25),
- (d) *means* for electrically connecting said indicators with a source of electric current and with said contact devices (circuits from transformer 65, wires 59-61, 103, 104, 105),
- (e) said indicators and said contact devices corresponding in number and arrangement and subdivided into corresponding groups,
- (f) *means* for energizing said indicators as the associated contact devices are operated (relays R),
- (g) an electrical circuit common to all of said groups and open until all of the indicators in one of said groups have been energized (circuit including conductor 98, relay R3 and conductor 114'),
- (h) and *supplementary means* for indicating a winning play when all of the indicators in one of said groups have been energized (win light L or bell 69).

Before discussing the prior art patents attention is particularly called to the fact that claim 3 is couched in very broad language in that generous use is made of the word "means." In particular, it is to be noted that in describing the relays R the term "*means* for energizing" is used. Likewise, in defining the win lamp L and signal

bell 69 the broad term “supplementary *means* for indicating” is used. With these facts in mind and the additional fact that the trial court in order to find infringement by the Fawn games construed these claims broadly, the prior art will now be discussed.

2. CLAIM 3 IS ANTICIPATED BY NAKASHIMA:

The Nakashima Patent No. 1,678,583, Defendant's Exhibit D-1 [R. 375-381], was issued July 24, 1928, approximately two and one-half years prior to the filing of the Gibbs patent application.

Like Gibbs, Nakashima set out to create an amusement device “adapted to signal the attendant and the player when the latter succeeds in making a winning play” [R. 379, lines 4, 5, 6]. Also like Gibbs, Nakashima designed a game having a playing board provided with a plurality of apertures or pockets into which a ball could be rolled, and an annunciator panel at the rear of the board provided with a plurality of lights, each of which was connected to a contact device immediately beneath one of the apertures on the game board.

Games having *all* of these features were old and well known even before Nakashima entered the field. (See the earlier patents to Hayashi, Esmarian and Mader [R. 388, 391, 397]. Nakashima had nine lights on his annunciator arranged in three rows of three each, and nine holes in his game board with a contact device beneath each of said holes to correspond to the nine indicator lamps on the annunciator board. To increase the hazards of play he provided 21 extra holes on the game board which did not have switches or lights. Gibbs coming along several years later provided hazards in the form of raised ribs or obstacles 51 in a manner similar to that taught by Esmarian [R. 391]. However, the net effect was the

same, *i. e.*, to make it more difficult for the player to get a ball in a pay hole.

The switches used by Nakashima like those used by Gibbs comprised a pair of spring contact members 18 and 19 extending beneath the aperture so that when a ball fell upon the upper contact it would be depressed to engage the lower contact, thereby closing the circuit to its corresponding indicator lamp on the annunciator board. The nine prize-winning apertures on the Nakashima board provided with contact switches were known as star numbers and were marked with stars on the board so that the player would know what to shoot for.

Nakashima realizing the advisability of having a win signal provided supplementary signal means in the form of a bell 14 which was operated by a relay 431 when a win had been made. The coil 433 of relay 431 is in series with the indicator lamps and is so adjusted that it will not operate its armature 434 until a group of three indicator lamps are energized.

However, when the player has succeeded in energizing any group of three lamps in the Nakashima game the relay 431 will attract its armature 434, thereby causing the contact member 435 to close the circuit between 436 and 437. The adjacent coil of the relay 432 being inductively coupled with the relay winding 431, a current is induced in the secondary winding 432 which is sufficient to operate the bell 14 signifying a win.

It is thus apparent that there is absolutely no difference in over-all structure and function between the Nakashima game and one of the Gibbs game units, since each is played by rolling a ball or balls across a game board to pass the ball into an aperture therein to operate a pair of contact members which close a circuit to an annunciator

lamp corresponding to the pocket in which the ball has rolled. When any group, three in the case of Nakashima and five in the case of Gibbs, of annunciator lights has been illuminated, supplementary signal means, a bell in the case of Nakashima, or a bell and win lamp in the case of Gibbs, is energized to notify all persons of the win. In each case the win signal circuit is common to all of the groups and is inactive until all of the indicators of a group have been energized. In the case of Gibbs the energization of the indicator lamps is maintained by relays while in the case of Nakashima this energization is maintained by using a plurality of balls to maintain the switches and the lamp circuits closed.

Applying our analysis of claim 3 to the Nakashima disclosure, we find that claim 3 reads equally well on Nakashima as it does on the Gibbs game. Following through the analysis by elements we see that:

- (a) The "*board*" of claim 3 is the game board 6 of Nakashima which is provided with a plurality of apertures arranged in rows and adapted to receive a ball therein in the manner shown by Gibbs.
- (b) "*a plurality of contact devices thereon adapted to be engaged by an object moved over the board by a player*" are of course the spring fingers 18, 19 of Nakashima arranged beneath the apertures in the same manner as Gibbs, each of the contact members 19 being adapted to be depressed by a ball 10 to thereby close a circuit by engagement with contact 18.
- (c) "*a plurality of indicators*" are the lamps 12 in the annunciator panel 15 of Nakashima arranged in horizontal and vertical rows so that a win can be made horizontally, vertically or diagonally as in Gibbs.

- (d) *“means for electrically connecting said indicators with a source of electric current and with said contact devices”* are the wires shown by Nakashima in Figure 4 which connect his contact devices to their corresponding indicator lamps and a source of power.
- (e) *“said indicators and said contact devices corresponding in number and arrangement and divided into corresponding groups,”* are the indicator lamps and contact devices of Nakashima which correspond in number and are arranged in groups. The Patent Office and trial court both held that arrangement of the lights or apertures in a particular order was immaterial and a mere matter of choice. The similarity in arrangement is closer between Nakashima and Gibbs than it is between Gibbs and Faulkner.
- (f) *“means for energizing said indicators as the associated contact devices are operated”* are the plurality of balls employed by Nakashima, there being a ball for each contact device to hold the same in closed position. The “means” of this element is not restricted to the relays shown by Gibbs or qualified in any way. It covers *all means*, and therefore the employment of a separate ball to hold each switch closed, meets this broad terminology.
- (g) *“an electrical circuit common to all of said groups and open until all of the indicators in one of said groups have been energized”* is obviously the circuit of Nakashima for operating his signal bell, which includes the induction coil 432, switch 436 and terminal 437. The bell circuit is common to

all of the Nakashima groups and is operated to indicate a win only when the last of a group of lights is illuminated.

- (h) *“and supplementary means for indicating a winning play when all of the indicators in one of said groups has been energized”* is of course the bell 14 in Nakashima which is caused to ring to indicate a winning play. When the third contact switch of a group in Nakashima is closed, sufficient current passes through coil 433 to move its armature 434 to close the bell circuit.

The Nakashima patent was a file wrapper reference against Gibbs and presumptively therefore was thoroughly considered by the Examiner. As a matter of fact, the Examiner used the Nakashima reference in rejecting various claims of the application as filed, but a reading of the file wrapper shows that the Examiner did not realize how complete the Nakashima showing was. Evidently the Examiner in permitting the use of the broad term “means” in element (f) had in mind the relays R of Gibbs and it did not occur to him that this broad language could be read on Nakashima when element (f) is given a literal interpretation as the trial court has given it in this case.

As previously mentioned, Gibbs uses his switches S merely to energize the self-holding circuit of his relays R and maintains illumination of his indicator lamps by means of the relays R and their armatures R' instead of using the switches S for that purpose. If element (f) of Gibbs' claim 3 had been properly limited to “electrical” means or “relay” means for accomplishing this purpose it would not be anticipated by Nakashima. However, by inclusion of the unqualified word “means” in his element

(f) Gibbs claimed the Nakashima game as well as his own and must now bear the consequences thereof.

Claim 3 is clearly anticipated by the prior patent to Nakashima and is therefore invalid.

3. CLAIM 3 IS ALSO INVALID FOR LACK OF INVENTION:

The Prior Art Patents to Hayashi, Esmarian and Mader.

HAYASHI *No. 1,614,471* [R. 383-390] issued January 18, 1927, discloses a game of the type shown by Nakashima and Gibbs having a board with a plurality of apertures into which a rolling object may fall, and an annunciator board with a plurality of lights thereon, each light being connected to a switch immediately under one of said apertures, said apertures and indicator lamps corresponding in number and arrangement as shown in the Gibbs patent. The game is played by means of peanut-shaped objects which are rolled over the game board and fall into the apertures to illuminate the corresponding indicator lamps. The score of the winner is dependent upon which group of annunciator lamps has been energized during the play.

ESMARIAN *No. 1,612,912* [R. 390-394] issued January 4, 1927, also shows a game board with a plurality of apertures adapted to receive a ball rolling across the board. An annunciator panel is provided at the back of the game board having a plurality of indicator lamps corresponding in number to the apertures in the playing board. Each indicator lamp is connected to a pair of contacts immediately below its corresponding aperture so that when a ball drops into the aperture its corresponding indicator lamp will be energized.

MADER *No. 1,622,330* [R. 397-405] issued March 29, 1927, likewise shows a game board with a plurality of apertures therein beneath each of which is a switch comprising a pair of resilient contact members. At the rear of the game board is an annunciator panel having six rows of five lights each arranged in horizontal and vertical lines as in Gibbs, each of said indicator lamps being connected to one of the aperture switches in the game board. It will be noted that the indicator lamps and contact devices correspond in number, with each of said indicator lamps having a particular scoring value.

SCHNEIDER *No. 1,788,336* [R. 408-410] filed December 16, 1927, has a game board provided with a plurality of apertures at its rear end and a plurality of indicator lamps corresponding in number and arrangement with the apertures with the exception that the apertures are disposed in a vertical line on the inclined rear portion of the game board whereas the indicator lamps are disposed in a horizontal line thereon. Each of said apertures is provided with a movable contact immediately therebelow adapted to be engaged by a ball falling through the aperture to energize its corresponding indicator lamp. A single ball is used which returns to the player after it has actuated the switch and energized the corresponding indicator lamp.

From the foregoing it is seen that the prior art patents to Hayashi, Esmarian, and Mader all show table games having a board, a plurality of contact devices thereon adapted to be engaged by an object moved over the board by a player, a plurality of indicators, means for electrically connecting said indicators with a source of electric current and with said contact devices, said indicators and contact devices corresponding in number, and in the case of Hayashi, also in arrangement, and means for energiz-

ing said indicators as the associated contact devices are operated.

In other words, each of these prior patents satisfies elements a, b, c, d, e, and f, of claim 3, leaving only the supplementary win signal and its operative circuit called for by elements g and h of said claim. However, as previously pointed out in detail, Nakashima besides meeting elements a, b, c, d, e and f, also shows a win signal and circuits therefor which exactly meet the terms of elements f and g.

Obviously it did not involve invention to merely add the win signal of Nakashima to the games of Hayashi, Mader or Esmarian. Yet this is all that claim 3 recites.

Furthermore, the multi-unit game patents to Chester, Wallace, Higuchi, Prina and Irsch, none of which were cited by the Examiner and will be discussed in detail later, all show the use of visual and/or audible signals which function whenever an individual game unit completes a win as called for in elements (f) and (g) of claim 3.

CHESTER *No. 1,598,711* of 1926 [R. 424] shows a win light 55 [see Fig. 2, R. 424, and Figs. 9 and 10, R. 428].

WALLACE *No. 1,697,701* of 1929 [R. 436] discloses both win lights and a bell [see Fig. 10, R. 438].

HIGUCHI *No. 1,454,968* [R. 450] shows win lights 105 [see Fig. 1, R. 460].

PRINA *No. 1,518,754* [R. 470] utilizes his highest lamp 10 [see Fig. 1, R. 470] as a win light.

IRSCH *No. 1,458,844* [R. 486; see Fig. 2, R. 488] provides an annunciator panel in which there is a marker for each game unit.

Each of these patents provides an electrical circuit open until a win has been made, and "supplementary means for indicating a winning play," *i. e.*, the exact structure and circuits called for by elements (f) and (g) of claim 3.

It clearly was not invention at the time Gibbs entered the field to add the win signal circuits of the multi-unit games above discussed to the board and ball game units of Nakashima, Hayashi, Mader and Esmarian. Conversely, there was no invention in substituting the game boards and annunciator panels of Nakashima, Hayashi, Esmarian or Mader in place of the electro-mechanical devices of the multi-unit games of Chester, Wallace, Higuchi, Prina and Irsch for successively effecting a series of visible steps toward a win.

In the "board and ball type" game units of Nakashima, Hayashi, Esmarian, Mader and Gibbs, the successive steps of a player toward a win are indicated by the successive illumination of a series of lights. In the multi-unit games of Chester, Wallace, Higuchi, and Irsch the player's progress toward a win is indicated by successive positions of a movable object traveling along a race track. Obviously it was a mere matter of choice when Gibbs entered the field which method was used to indicate the player's progress, particularly in view of Prina who used the successive light method of the board and ball game units in his competitive multi-unit game.

"Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent; and it was decided by this court, more than a quarter of a century ago, that unless more ingenuity and skill were required in making or applying the

said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.”

Dunbar v. Myers, 94 U. S. 187, 191.

Furthermore, Mr. Gibbs’ own testimony shows that prior to designing the game illustrated in the patent in suit he was fully familiar with the old games of Bingo and Tango [R. 69, 77] and also with the Wallace and Higuchi games [R. 76, 147, 149-151]. As a matter of fact, Mr. Gibbs operated one of the Wallace pig games known as a “Grunt Derby” immediately prior to building his first electrified bingo game.

Consequently, we have a situation where the Plaintiff-Patentee not only had constructive knowledge of the prior art, but also had actual working knowledge thereof.

Additionally, we have the testimony of Mr. Porter [R. 172] who first laid out the wiring diagrams for Mr. Gibbs, and Mr. Cannon [R. 231] who re-designed the wiring of the Gibbs games and manufactured them for Gibbs, to the effect that no invention was involved in designing the particular electrical or mechanical structures shown in the Gibbs patent. Likewise, the Plaintiff’s expert Mr. Burke testified [R. 100-103] that it would be quite simple for him as an electrical engineer, once a person had requested him to build an electrified Bingo game, to put together any number of circuits which would accomplish this result.

Since the prior art shows, and the Examiner so held, that the broad idea of an electrified Bingo game was not patentable to Gibbs, and since out of the mouths of the Plaintiff, his witnesses and associates, comes a vehement denial that any invention whatever was required to create the structures and circuits of the Gibbs game, we come

inescapably to the conclusion that no invention whatsoever was present in the Gibbs patent.

A brief reference to the Gibbs file wrapper, Exhibit C in evidence, shows that all of the broad claims submitted by Gibbs when he filed his application to the general idea of an electrified Bingo game were rejected by the Patent Office, in which rejection Gibbs acquiesced. The only claims which were allowed by the Examiner, and the only claims therefore which can measure and define the alleged invention of Gibbs are claims which include the self-same electrical and structural features which were by the testimony of Plaintiff, his witnesses and associates merely the exercise of the ordinary mechanical and electrical skill of people working in that art.

In designing the game of his patent Gibbs merely electrified the well known game of Bingo. For the Bingo basket having a plurality of pockets into which a ball was thrown, Gibbs used a well-known game board of Nakashima and others having a plurality of pockets into which a ball was rolled. For the Bingo cards upon which the players placed markers corresponding to the numbers of the pockets into which the Bingo ball was thrown, Gibbs used the conventional annunciator panel of Nakashima and others having lights corresponding to the apertures on the game board.

The player instead of throwing a ball at a basket having pockets therein, rolled the ball into pockets on the game board, and in lieu of the player placing a marker on his numbered card the player saw a light corresponding to

that number. The rules of play were exactly the same and when one player effected a win, *i. e.*, five markers or lights in a row, the game was stopped. *How could this possibly be invention?*

As was aptly stated by Mr. Justice Bradley in *Atlantic Works v. Brady*, 107 U. S. 192, at page 200:

“The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary process of manufacture.

“Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement and gather its foam in the form of patent monopoly which enables them to lay a heavy tax on the industry of the country, without contributing anything to the real advancement of the art. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits, and vexatious accountings for profits made in good faith.”

From the foregoing discussion it is seen therefore, that claim 3 is invalid both for lack of novelty over Nakashima, and for lack of invention.

C. CLAIM 6 IS INVALID.

Claim 6 is directed to the complete multi-unit game shown in the Gibbs patent which comprises a plurality of the individual game units defined in claim 3. It will be seen, however, that in describing the individual game units, claim 6 uses much broader terminology than claim 3 and does not limit the units to a board game as does claim 3. The broad language in the first portion of claim 6 encompasses not only board games of the type shown by Gibbs, Nakashima and others, but also the competitive game of Prina [R. 470] previously mentioned, which will shortly be discussed in detail. The balance of claim 6 obviously reads on Prina and the other multi-unit games of the prior art as will be pointed out later.

Claims 7 and 8 are dependent upon claim 6 and likewise are met by the prior art.

Analyzing claim 6, we find that it logically breaks down into elements which are identified in the Gibbs patent as follows:

1. ANALYSIS OF CLAIM 6:

A game apparatus comprising

- (a) a plurality of units (U1, U2) electrically connected together, each of said units including
 - (1) a plurality of contact devices (switches S, 53-54) and
 - (2) a plurality of indicators (lamps 1-25),
 - (3) corresponding in number and subdivided into corresponding groups,
- (b) *means* for electrically connecting the contact devices with the corresponding indicators (circuits connecting switches S with relays R and lamps 1-25),

- (c) *means* for electrically connecting said units together and with a source of electric current (wires 59, 60 and 61),
- (d) said indicators adapted to be operated when and as objects are moved by the players into engagement with the contact devices, and
- (e) *means* (relays R3 and R2) whereby when all of the indicators in any group of any one of said units have been operated to complete a winning play
 - (1) the indicators on all of the units except the winning unit will be de-energized
 - (2) while the indicators at the winning unit will remain energized for the purpose described.

As mentioned above, the first portion (a, b, d), of claim 6 merely specifies that each of the game units shall have

“a plurality of contact devices and a plurality of indicators corresponding in number and sub-divided into corresponding groups, said indicators being adapted to be operated when and as objects are moved by the players into engagement with the contact devices.”

The balance of claim 6 then specifies that these broadly described game units shall be electrically connected together and means provided whereby when a win has been accomplished the indicators on the winning unit remain illuminated and those on the competing units go dark.

If the patent Examiner handling the Gibbs application had made even a cursory examination of the prior art in the field of competitive games of the Gibbs type he would have found at least some of the multi-unit game

patents included in Defendant's Exhibit D herein, and obviously would not have allowed claim 6 and its related claims. However, the Examiner did *not cite a single multi-unit game patent* against the Gibbs claims, but allowed claim 6 and other claims directed to the entire game on the first Office action.

There is no explanation in the file wrapper or elsewhere of this obvious failure by the Examiner to properly examine the Gibbs application while it was in the Patent Office. With such careless examination on the part of the Examiner it is understandable why he did not fully appreciate the Nakashima patent as hereinbefore discussed.

As clearly shown by the patents to Prina, Chester, Higuchi, Wallace and Irsch, the broad idea of electrically interconnecting a plurality of game units in such a manner that when a win is made, the winning unit is maintained in *status quo*, a win signal is operated and the competing units disconnected, was old in the art. That this sequence of events is necessary in any competitive game operated in an amusement park is obvious.

Gibbs admitted [R. 76, 147, 149] that these three fundamentals in competitive games as shown by the Wallace Grunt Derby and the Higuchi Coney Racer were old and well known to him at the time he designed his electrified Bingo game. Each of these prior art games accomplished the above-mentioned three functions which constitute the essence of claim 6.

As will be pointed out hereinafter, claim 6 and claims 7-10 which are also directed to the complete competitive game of Gibbs are invalid for lack of invention, but before discussing this defense we will point out how Gibbs by his broad language in claim 6 overstepped the permissible

bounds of claim writing and directly covered the prior art structure shown in the Prina patent [R. 470-484].

“To grant to a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences.”

Atlantic Works v. Brady, 107 U. S. 192, 199.

2. CLAIM 6 IS ANTICIPATED BY PRINA:

The Prina Patent No. 1,518,754 [R. 470-484] which issued approximately seven years prior to the Gibbs application shows a competitive game made up of a plurality of units each operated by a separate player, the results of the players' progress being “made manifest along a visible field by means of a progressive series of lamps for each unit” [R. 477]. This is of course the same as the Gibbs game where the progress of each player is visible as the successive lamps are illuminated.

It will be noted from Figure 1 of Prina that he provides a plurality of manipulators A-J, each of which is to be operated by a separate player, which are connected to individual annunciator panels a-j. The manipulators A-J each comprises a wheel 17 [see Fig. 4] which is gear-connected to a pivoted switch arm 26 carrying a contact shoe 29 adapted to sweep up and down over a plurality of contact buttons 1a-9a, inclusive. The contact buttons 1a-9a are connected to indicator lamps 1-9, inclusive, so that as the movable contact 29 engages a contact button, its corresponding indicator lamp will be energized.

In the operation of the game the player rotates his hand wheel 17 at various speeds in order to successively energize the indicators 1-9 which will thereupon remain illuminated during the play.

After the ninth lamp is lighted, a higher speed of rotation must be obtained to cause the win lamp 10 to be lighted. When this proper speed is attained the win lamp 10 will be energized and the competing units are instantly shut down. It will be noticed that the win light 10 is on a separate auxiliary circuit which is energized after the first nine lights are illuminated in the same manner as the Gibbs win signal circuit is energized after five of his lights in a line have been illuminated.

Applying Prina to claim 6 we find that it completely meets each and every essential element thereof. To clearly show this anticipation of claim 6 by the Prina patent we will now reproduce the analysis of claim 6, in the outline form heretofore used, pointing out wherein each of the elements of this claim is met by corresponding parts of the Prina disclosure.

CLAIM 6:

A game apparatus comprising

- (a) a plurality of units electrically connected together, each of said units including
 - (1) a plurality of contact devices (Prina contact buttons 1a-9a, inc.) and
 - (2) a plurality of indicators (Prina lamps 1-9, inc.)
 - (3) corresponding in number (Prina lamps 1-9 correspond in number to his contacts 1a-9a) and
 - (4) subdivided into corresponding groups (the Prina lamps and contact devices can be subdivided into groups if desired)

- (b) means for electrically connecting the contact devices with the corresponding indicators (Prina connectors 1b-9b)
- (c) means for electrically connecting said units together with a source of electric current (Prina main leads 36, 37 and auxiliary leads 40 and 55)
- (d) said indicators adapted to be operated when and as objects are moved by the players into engagement with the contact devices (Prina indicators 1-9 are operated when shoe 29, moved by the player in response to rotation of hand wheel 17, engages the contacts 1a-9a)
- (e) means whereby when all of the indicators (Prina lamps 1-9) in any group of any one of said units have been operated to complete a winning play
 - (1) the indicators on all of the units except the winning unit will be de-energized (accomplished by breaking main line contacts 39, 52 which shuts off power to competing game units)
 - (2) while the indicators at the winning unit will remain energized for the purpose described (closing of auxiliary power circuit for winning unit to switch 53, 54 which maintains indicators 1-9 and win lamp 10 illuminated on the winning unit. [R. 479, lines 85-90]).

It is thus seen that because of the broad terminology of claim 6 the Prina patent meets each and every element thereof with the one exception that he does not subdivide his indicators into groups as mentioned in element a-4. However, as mentioned previously, the Patent Office held

and Gibbs acquiesced thereto, and the trial court so held, that it is immaterial whether the indicators be arranged in one large or in several small groups since the result, to-wit, the accomplishment of a win when a given number of lights are energized, is the same in each case.

Claim 6 then is therefore fully anticipated by the Prina patent and consequently invalid, it being remembered that there is no mention whatsoever in this claim of a game board or a ball, or apertures for the ball to pass through. In other words, Gibbs in his attempt to broadly cover his device again overstepped himself and extended his monopoly to cover the Prina game as well as his own. As is so often stated, "That which infringes if later, anticipates if earlier" (*Miller v. Eagle*, 151 U. S. 186), and since Prina would infringe Gibbs' claim 6, it being prior in time, invalidates claim 6.

3. CLAIM 6 IS ALSO INVALID FOR LACK OF INVENTION:

Referring back to our analysis of claim 6, it will be seen that elements a, b and d thereof specify that the individual units shall include

"a plurality of contact devices and a plurality of indicators corresponding in number and subdivided into corresponding groups, means for electrically connecting the contact devices with the corresponding indicators, * * * said indicators adapted to be operated when and as objects are moved by the players into engagement with the contact devices."

This portion of claim 3 even if narrowly construed by reading into it words which are not there, describes the board and ball games of Nakashima, Hayashi, Esmarian and Mader, since each of these prior patents discloses a game board having a plurality of apertures and contact

devices therein and a plurality of indicators corresponding to said contact devices, electrically connected thereto and adapted to be operated when a ball is moved by the player into engagement with said contact devices.

Obviously then, the first half of claim 6 was old in the art when Gibbs entered the field and if the claim is to be allowable we must look elsewhere for novelty therein.

Element (c) of course adds nothing novel to the combination since it merely re-recites part of element (a), to-wit, "means for electrically connecting the units together and with a source of power." This leaves only element (e) as a possible source of novelty.

Examining element (e) we find that it recites:

"means whereby when all of the indicators in any group of any one of said units have been operated to complete a winning play the indicators on all of the units except the winning unit will be de-energized while the indicators at the winning unit will remain energized."

It will be recognized that the foregoing is rather broad language, and as hereinbefore stated, reads directly on the prior art patents now to be discussed.

CHESTER *Patent No. 1,598,711* [R. 423-434] issued in 1926 shows a competitive game made up of a plurality of electrically interconnected units, each operated by an individual player by means of a wheel 19 to advance a pair of dancers 31 around a circular track. When the dancers reach their goal they close a win switch 30 which operates relay 53 to energize relay 62 in the main line to cut off power to the non-winning game units. The operation of relay 53 also closes the circuit to a win

lamp 55 and sets up a transfer circuit to maintain said lamp energized after the win is made and the competing units are disconnected. It is thus seen that the patent to Chester fully and completely meets all of the terms of elements (c) and (e) of Gibbs' claim 6.

WALLACE *Patent No. 1,697,701* [R. 434-447] issued in 1929 covers the apparatus referred to by Mr. Gibbs in his testimony as the "Grunt Derby." In this game a number of parallel race tracks are provided, each with a moving object in the form of a pig and a little boy. The players are each provided with an individual playing board (as in Gibbs) over which the player rolls a ball to make it pass through one of the apertures at the rear of the board. A switch is disposed under these apertures so that the ball in passing through any one of them closes the switch to complete a circuit to an electric motor which advances the pig a short distance up its particular track.

The object of the game is to get one of the pigs to traverse the path to the winning position, and when the pig has arrived at its goal a win lamp circuit is closed showing which unit has won and at the same time operates a power relay to cut off the power to the other games. It is to be noted that in addition to clearly meeting elements c and e of claim 6 that Wallace additionally shows a board and ball game of the Gibbs type.

HIGUCHI *Patent No. 1,454,968* [R. 450-467] illustrates the Coney Racer with which Mr. Gibbs was familiar at the time he designed his game. Higuchi had a racing game quite similar to that of Wallace except that it employs rabbits instead of pigs, as seen best in Fig. 1 [R. 460]. Each player was provided with a manually operated catapult device for throwing a ball so that it would

engage electrical contacts which would in turn operate a motor to advance the player's rabbit a certain distance up the race track. When a win is made a win lamp 105 is energized and the other games are de-energized. Here again we find a competitive prior game which completely meets the terms of elements c and e of Gibbs' claim 6.

IRSCH *Patent No. 1,458,884* [R. 486-494] shows another competitive game wherein a plurality of individual game units are electrically connected together, each provided with a duck that travels along a path as the operator rotates a wheel 68. An annunciator panel 2 is provided to indicate a win when a player causes his duck to travel the full length of the track and deposit an egg into a cup 24. The weight of the egg depresses spring contact 26 causing it to engage stationary contact 27 to close the annunciator circuit for that particular game, thus announcing the fact of the win. Completion of a win by one player disconnects through movement of main switch 59 all of the competing games, which again satisfies the terms of elements c and e of claim 6.

It is not difficult to see how Mr. Gibbs, who at the time of making his alleged invention was operating one of the Wallace Grunt Derbys, should progress from the Grunt Derby to the electrified Bingo game disclosed in his patent. Being familiar with the popular game of Bingo, his natural approach to the problem was to duplicate the conventional Bingo basket and card on the game board and annunciator panel respectively, of the Nakashima, Hayaishi, Esmarian and Mader games, thereby producing his single game unit; and then to hook up his units as in the Wallace game which he was then operating, or the Higuichi game with which he was familiar. Certainly these thought processes and actions did not rise to the dignity

of invention and did not justify the grant of patent monopoly.

Plaintiff's expert and associates testified that once this general concept was given to anyone skilled in the art the particular mechanism and circuits for accomplishing the same amounted to nothing but ordinary skill which any technician could supply. For example, the game units could be connected in the manner taught by Prina or Chester which is the system followed by the defendant, or they could be connected as shown by Wallace or Higuchi with which Gibbs was familiar.

As the Supreme Court said in the case of *Standard Brands v. National Grain*, 308 U. S. 34:

"His process is the result of the exercise of the skill of the calling, the application of an old principle to a similar or analogous subject with no change in the manner of application and without any substantially different result."

D. CLAIMS 7 AND 8 ARE INVALID.

1. CLAIM 7 IS ANTICIPATED BY PRINA AND VOID FOR LACK OF INVENTION:

Claim 7 is dependent upon claim 6, merely adding thereto

"an independent supplementary signal at each of said units for signalling a winning play to the players."

which in the Gibbs game is the win light L or the bell 69.

It is at once apparent therefore that claim 7 is also anticipated by Prina since the win light 10 of Prina is identical with the win light L of Gibbs. Since Prina anticipates claim 6 it also therefore anticipates claim 7.

Furthermore, the game of Nakashima has a supplementary win signal, to-wit, his bell 14, and similar win

signals are shown in the multi-unit game patents such, for example, as the win lights 55 of Chester, the lamps 67 of Wallace, the win lamps 105 of Higuchi, and the annunciator windows of Irsch. Consequently, claim 7 is also invalid for lack of invention since it adds nothing to claim 6 not shown by the same prior patents which invalidate claim 6.

2. CLAIM 8 IS ANTICIPATED BY PRINA AND VOID FOR LACK OF INVENTION:

This claim also depends upon claim 6 and must stand or fall with claim 6 for the same reasons ascribed to claim 7:

Claim 8 merely adds to claim 6 the limitation found in claim 7, to-wit,

“an independent supplementary signal for signalling a win”

and in addition thereto

“means under the control of the operator for opening and closing the circuits of all the units simultaneously at will.”

This latter element is the main switch 68 in the Gibbs patent.

Such means are present in the patents to Chester (switch 71), Wallace (switch 64), Higuchi (switch 74) and Irsch (switch 59) and are inherent in the Prina game as illustrated. Obviously it would not be invention to add a main circuit switch to any electrical apparatus, and claim 8 like claims 6 and 7 is anticipated by Prina and is additionally void for lack of invention over the other patents cited.

E. CLAIMS 9 AND 10 ARE INVALID.

1. CLAIMS 9 AND 10 CLAIM AN INVENTION OTHER THAN THE ONE DISCLOSED:

To facilitate consideration of claim 9 it is reproduced here in outline form as follows:

ANALYSIS OF CLAIM 9:

A game apparatus comprising

- (a) a plurality of electrically connected units each including
 - (1) a game board (C) with a plurality of apertures therein (26-50) and
 - (2) an annunciator (A) with a plurality of indicators thereon (lamps 1-25),
- (b) electrical contacts (switches S) adjacent each of said apertures connected in the circuits of said indicators,
- (c) said indicators and said apertures corresponding in number and subdivided into corresponding groups
 - (1) whereby when objects are deposited in said apertures by the players at the several units, corresponding indicators will be energized.
- (d) a supplementary signal circuit on each of said units (conductors 109-110 to win lamp L)
- (e) and *means* for holding said signal circuit open until all of the indicators of any group on *each* of said units have been energized
- (f) and for closing said signal circuit when *all* of the indicators of any *unit* have been energized
- (g) and *means* controlled by the closing of the signal circuit of the winning unit for discontinuing the signals and opening the circuits of the indicators on all other units.

From the above outline it is readily apparent that claim 9 is ambiguous and indefinite in reciting a game apparatus not disclosed in the Gibbs patent. In elements e and f above the claim recites

“*means* for holding said signal circuit open until all of the indicators of any group on *each* of said units have been energized and for closing said signal circuit when *all* of the indicators of any *unit* have been energized.”

In the Gibbs game as disclosed in the specification, the supplementary signal circuit is closed when all of the indicators in any *group* of any *one* unit are energized, *i. e.*, the win circuit is closed as soon as any *group* of five lights in a row on any of the game units is energized. There is no showing whatsoever in the Gibbs specification of means for holding the signal circuit open until a group on *each* unit is energized, nor of means for closing the signal circuit when *all* the indicators of a *unit* have been energized. Consequently claim 9 is void as claiming an invention not disclosed in the specification.

Furthermore, elements e and f are inconsistent with each other since element (e) provides means for holding the signal circuit open until all of the indicators in any *group on each* of the units is energized, whereas element (f) provides for closing said circuit when *all* of the indicators of any *unit* have been energized. Since elements (e) and (f) are both talking about the same circuit it is obvious that one of them is wrong—the circuit can't meet *both* requirements. As a matter of fact, both elements are wrong as previously mentioned.

Claim 10, being dependent upon claim 9 is likewise invalid for the ambiguities set forth in claim 9 and as not claiming the invention described in the Gibbs patent.

2. CLAIMS 9 AND 10 ARE INVALID FOR LACK OF INVENTION :

Claim 9 is a somewhat narrower version of claim 6 and is not only void for claiming an invention other than that disclosed in the specification, but is also invalid for lack of invention over the prior art patents heretofore discussed.

Elements a, b and c of claim 9 describe a single Gibbs unit in practically the same language as used in elements a, b and d of claim 6 except that the unit is described as one employing a game board with a plurality of apertures into which objects may be deposited to operate the electrical contacts. The balance of claim 9, to-wit, elements d, e, f and g, *attempt* to describe the same subject matter as the last half of claims 6 and 7, but in somewhat different language.

As was the case with claim 6, the first portion of claim 9 reads squarely on the board and ball game patents of Nakashima, Hayashi, Esmarian and Mader with the one exception that the indicators and apertures are stated as being subdivided into groups. However, as previously mentioned, the original claims of the Gibbs application which were directed to this feature were all rejected by the Examiner on the ground that "no invention would be involved in connecting certain groups of holes 14 in Esmarian with a master signal in view of Nakashima."

The acquiescence of Gibbs to this rejection by the Examiner of claims directed to the feature of subdividing the apertures and lights into groups now estops the Defendant from urging that this element contributes anything to the patentability of the claim.

Each of the prior art patents, Nakashima, Hayashi, Esmarian and Mader, discloses a game apparatus com-

prising an electrical unit including a game board with a plurality of apertures therein, an annunciator having a corresponding number of indicators, and electrical contacts adjacent each of said apertures connected in the circuits of said indicators, whereby when objects are deposited in said apertures by the players at the several units, corresponding indicators will be energized.

The last half of claim 9 (elements d, e, f and g) to the extent that it is intelligible describes, as does the last half of claims 6 and 7, the circuits connecting the individual game units together so that when there is a win, a win light on the winning game will be illuminated and the competing units will be disconnected.

This last portion of claim 9 is even more clearly met by the multi-unit game patents to Prina, Chester, Wallace, Higuchi and Irsch than was claim 6, each of which shows a "supplementary signal circuit" which when closed "discontinues" the competing game units.

In summary, then, it is apparent that claim 9 like claim 6 is unpatentable over any one of the patents to Nakashima, Hayashi, Esmarian or Mader in view of any one of the competitive game patents to Prina, Chester, Wallace, Higuchi or Irsch. By simply combining any one of the first group with any one of the second group, the entire Gibbs construction of claim 9 is obtained. Hence claim 9 is void for lack of invention.

As was said by this Court in the case of *Ray v. Bunting Ironworks*, 4 F. (2d) 214,

"The selection and putting together of the most desirable parts of different machines in the same or kindred art, making a new machine, but in which each part operates the same way as operated before and effects the same result cannot be invention."

Claim 10 is dependent upon claim 9 and merely adds to claim 9 the limitation of

“an audible signal commonly connected with all of said units and adapted to be operated upon the closing of the supplementary signal circuit of any of said units.”

The addition of this element does not help the validity of the claim in the slightest since such an audible signal is shown in the same prior art patents which invalidate claim 9.

An audible signal is found in the Nakashima, Wallace and Mader patents, and furthermore, it could not possibly amount to invention to merely substitute an audible signal for a visual signal in the other prior art games where the two are admittedly equivalent.

Consequently, it is apparent that claim 10 must fall with claim 9,

- (1) because being dependent on claim 9 it is ambiguous and describes an invention other than the one shown in the Gibbs patent, and
- (2) because its addition to claim 9 cannot lend patentability to an otherwise invalid claim.

The Supreme Court in *Powers Kennedy Co. v. Concrete Company*, 282 U. S. 175, stated the situation with respect to claim 10 very succinctly as follows:

“Neither the combination of old elements or devices accomplishing no more than an aggregation of old results nor the use of an old apparatus or appliance for a new purpose is invention.”

II.

The Issues of Infringement.

A. CONSTRUCTION AND OPERATION OF THE OLD FAWN GAME.

The old Fawn game is described in detail commencing at page 5 of the Appendix and we will only point out here the essential parts thereof necessary for our consideration of the issues of infringement.

The old Fawn game [see photographs, R. 325-341] comprised a number of game units, each to be played by a separate player, each unit including a game board over which a player repeatedly projected a ball. The game board had 24 holes through which the ball could pass, the holes being arranged in two lateral rows of 12 holes each. The ball in passing through any of the holes on its way to be returned to the player for additional play operated a paddle, one of which was located beneath each hole. Each paddle was part of a switch in circuit with an indicator light on an annunciator panel for that unit. The paddles were balanced so that once depressed by the ball falling thereon they stayed depressed to keep the switch closed and their corresponding indicator lamp lit. The panel included 25 lamps arranged in vertical and horizontal rows in the same manner as shown in the Gibbs patent.

Each of the paddles when depressed by the passage of the ball released a pin on one of a series of wheels beneath the game board, the wheels having additional pins engaging "win" bars so that when all of the paddles for any horizontal, vertical, or diagonal group of indicator lamps had been depressed, the vertical "win" bar, the horizontal "win" bar, or the diagonal "win" bar would be moved by

the wheels causing a mercury switch carried by another bar to close a separate "win" circuit.

The completion of the "win" circuit energized a "win" relay which (a) energized a supplementary signal lamp on top of the annunciator panel; (b) disconnected the normal power circuit supplying power to the indicator lamps of the winning unit; (c) closed an auxiliary power circuit to the indicator lamps on the winning unit; and (d) actuated a main power relay to disconnect the supply of power to all of the other units, thus stopping the game.

The game was re-started by the operator actuating a restart lever common to all of the units which lifted all of the paddles back to their pin engaging position and opened the indicator lamps' circuits which had been closed by the depressed paddles. This action also opened the mercury switch, de-energizing the "win" relay and allowing the main power switch to re-close.

This game had no audible signal corresponding to the Gibbs audible signal 69. Likewise, it did not have individual lamp relays or any means other than the paddle switches for maintaining the indicators energized.

B. CONSTRUCTION AND OPERATION OF NEW FAWN GAME.

The new Fawn game includes the same structural and mechanical units including game boards, annunciator panels, the paddles beneath the holes in the game boards, the pin and wheel mechanisms for controlling the mercury switches, and the mechanism for resetting the paddles when a game is to be restarted, as were present in the original Fawn game.

However, the *supplementary signal light* on each of the unit annunciator panels has been eliminated.

Also the circuits have been changed so that the new Fawn game is *not* competitive as was the old game. The operation of the “win” relay on any unit does *not* shut down the other game units but on the contrary all of the units remain energized even though the “win” relay on one or more of the units is actuated.

The stopping of the game is controlled solely by a time clock. The clock is started at the beginning of a game when the operator actuates the restart lever and the game continues for the time period for which the clock is set. At the end of the predetermined time the clock opens the main power switch, stopping the game and stopping the clock until it is restarted by the operator of the games. Since the completion of a winning row of indicator lights on one unit does not stop the game, the other players continue the play until the end of the clock time period, thereby making it possible to have several winners. The lights are extinguished only at the end of the time period.

In the altered Fawn game there is *no* audible signal corresponding to the Gibbs audible signal bell 69, and of course *no* win lamp L. (For a detailed description of the new Fawn game see Appendix, p. 10.)

C. THE NEW FAWN GAME DOES NOT INFRINGE.

1. CLAIMS 9 AND 10 ARE NOT INFRINGED BY THE NEW GAME:

As has been pointed out heretofore, claims 9 and 10 to the extent that they are intelligible are directed to the same subject matter as claims 6 and 7, being merely narrower versions thereof. Since the trial court held that the new Fawn game did *not* infringe broad claims 6 and 7, it is obvious error for the court to have held *narrow* claims 9 and 10 infringed by the new Fawn game. In this connec-

tion it is interesting to note that Plaintiff neglected to present any findings to try and substantiate this erroneous ruling of the Court. Nor is any hint given in the Court's opinion. We are left completely in the dark on the subject.

It is axiomatic that if a *broad claim is not infringed* by an accused structure, then *narrower versions* of that claim *cannot possibly* be infringed.

This elementary rule of patent law was finally recognized by the trial court when after having first found broad claim 6 not infringed but its *dependent* claims 7 and 8 infringed, the Court reversed itself and conceded that claims 7 and 8 also were not infringed. This ruling is found on pages 288 and 289 of the Record as follows:

“Mr. Fulwider: In view of the fact that claims 7 and 8 depend directly on 6, is it your Honor's intention to hold them infringed, whereas the broader claims would not infringe?

The Court: Only to that extent.

Mr. Fulwider: My thought was if claim 6, the broad claim, is not infringed, then claims 7 and 8, the narrow claims, *could* not be infringed. . . .

The Court (to Mr. Huebner): What is your view about that? I think they *probably* fell with it. I think Mr. Fulwider is right.

Mr. Huebner: I think the point he makes is correct, so far as the application of the rules go.

The Court: I will eliminate 7 and 8, because they are dependent on 6.”

Even a cursory reading of claim 9 shows that it, like claim 7, is merely a narrow version of claim 6. This fact was ignored by the trial court and evaded by counsel

for Plaintiff as appears on page 289 of the Record as follows:

“Mr. Fulwider: May I ask a question of Mr. Huebner along that line: Isn’t it true also, Mr. Huebner that 9 and 10, although written independently are narrower than claim 6, and are directed to the same subject matter?

Mr. Huebner: I decline to answer that.

The Court: I think we will let them stand. The chief claim we are interested in is claim 3.”

Since there are no Findings to substantiate the trial court’s ruling that the new Fawn game infringed claims 9 and 10 we must refer to the Court’s discussion with Plaintiff’s counsel during his final argument and the Court’s opinion to try and find the answer to this anomaly.

As is apparent from said discussion and the Court’s opinion, *the Court held* that the Defendant by *changing* the old Fawn game to a *non-competitive game* removed the game from the scope of claim 6. See R. 262, where the Court stated with respect to the *new* Fawn game as follows:

“The Court (to Mr. Huebner): * * * That is the fundamental distinction, that while there is a possibility that several persons may win, and also the possibility that no one might win in his (Faulkner’s) game, while your game goes on until somebody wins. So here are two differences in result. His games stop automatically after a minute and a half. Your game goes on until somebody wins.”

This thought was further stated by the trial court at R. 267 as follows:

“The Court: * * * Therefore the second elements of claim 6 are not in the altered Fawn game.”

In the Court's opinion we find a further statement to the same effect at R. 287 as follows:

"The Court: * * * The (new) Fawn game is played for a definite time,—a minute and a half, making it possible for two persons to win during the course of the game, one after the other. * * *

The result is that under the (new) Fawn game there can be any number of winners, and it is possible that no one should win, during that time, while under the Gibbs game only one player may win and there is always a winner, because the game does not stop until one person has won. In the other game, as I have already stated, the time clock automatically stops all games, * * *

* * * *I do not think that claim 6 is infringed, and I think if you read them the way counsel desires me to read them, they would fall under the interdict of the recent decision of the Supreme Court in Halliburton v. Walker."*

The foregoing and like rulings by the Court were embodied in Alternate Findings XIX, XX and XXIV proposed by Defendant [R. 27, 28, 39] but for some reason were not adopted by the Court, although the Decree of course in effect finds no infringement of claims 6, 7 and 8.

The elements of claim 6 which the Court referred to as being absent in the new Fawn game are those set forth as element (e) in the analysis of claim 6 outlined earlier in this Brief. Element (e) reads as follows:

- (e) “means whereby when all of the indicators in any group of any one of said units have been operated to complete a winning play
 - (1) the indicators on all of the units except the winning unit will be de-energized
 - (2) while the indicators at the winning unit will remain energized for the purpose described”.

Element (e) of claim 6 obviously refers to the relays R2 and R3 in the Gibbs structure which, as soon as a winning play has been made, disconnect the competing games while effecting a power transfer to an auxiliary circuit in the winning game so that its lights will remain energized. The win circuit of which R3 is a part also energizes an independent supplementary signal, to-wit, the win lamp on top of the winning game, which is what claim 7 adds to its parent claim 6.

Referring to claim 9, we see that this same structure, to-wit, the win circuit and relay R3 is described in elements d, e, f and g as follows:

- (d) a supplementary signal circuit on each of said units
- (e) and *means* for holding said signal circuit open until all of the indicators on any group on each of said units have been energized
- (f) and for closing said signal circuit when all of the indicators of any unit have been energized
- (g) and *means controlled by* the closing of the signal circuit of the winning unit for *discontinuing* the signals and opening the circuit of the indicators on all other units.

The “supplementary signal circuit” of element (d) is obviously the circuit for the win lamp L, but in order to have the rest of the claim make any sense it must be assumed that Gibbs means to also include in his “supplementary signal circuit” his win circuit and relay R3 which are in parallel with the win lamp circuit. With this interpretation given to element (d), element (g) makes sense. Otherwise, it is unintelligible.

Element (g) of claim 9 covers exactly the same subject matter as set forth in element (e-1) of claim 6, *i.e.*, that when a win is accomplished *the lights of the non-winning games will be disconnected*. This is the element in claim 6 that the trial court found lacking in the new Fawn game. It follows as a matter of course therefore under the trial court’s own reasoning and ruling that claim 9 is not infringed for the same reasons that claim 6 is not infringed. The lower court was clearly in error in not so holding.

Since *claim 10* is dependent upon claim 9, and since claim 9 is not infringed, therefore, claim 10 *cannot possibly* be infringed.

Additionally, claim 10 is obviously not infringed because there is no “*audible signal commonly connected with all of said units*” to be found in the new Fawn game. The evidence on this point is uncontroverted.

It is therefore seen that claims 9 and 10 by a simple reading thereof and comparison with claim 6 cannot be infringed, since claim 6 was held by the lower court *not* to be infringed.

2. CLAIM 3 IS NOT INFRINGED BY THE NEW FAWN GAME:

Here again the trial court apparently ignored the plain wording of the claim in ruling that claim 3 was infringed by the new Fawn game. There is nothing in the Court's opinion or in the Findings of Fact to indicate why the Court made this ruling so we can only guess as to the Court's reasons therefor. The lack of Findings is of course understandable since Plaintiff could not frame a finding which would back up the Court's ruling.

The only reference in the Findings to the construction and operation of the new Fawn game appears in the latter portion of Finding No. 12 [R. 37] which compares the new Fawn game to the old game and states that the new game is illustrated in Exhibit 9. Nowhere in this or any other finding is there any foundation for the Court's ruling that the new Fawn game infringed claim 3.

On the contrary, Finding No. 12 [R. 37] in the sentence commencing with the last word in line 20 lays a foundation for a ruling that the new Fawn game does *not* infringe claim 3. In this sentence it is stated that:

“certain electric globes at the top of each unit of said game were removed.”

What the Finding neglected to say, however, and which of course it could not say since it was supposed to support the Decree, was that these “certain electric globes” which were removed *were the win lights 22* of the old Fawn game. Finding No. 12 *should* have said directly what it evasively said by inference, to-wit, that the new Fawn game has *no win lamp or other means for signalling a win*, as required by the last element of claim 3.

It should not be necessary to elaborate on the above self-evident fact, but since the Plaintiff may pursue on this Appeal some of the tenuous theories advanced by him at the trial, we will take a few moments to thoroughly document our position that element (h) is totally lacking in the new Fawn game. For this purpose claim 3 is here reproduced with elements g and h separately set forth as follows:

Claim 3:

A game apparatus comprising a board, a plurality of contact devices thereon adapted to be engaged by an object moved over the board by a player, a plurality of indicators, means for electrically connecting said indicators with a source of electric current and with said contact devices, said indicators and said contact devices corresponding in number and arrangement and sub-divided into corresponding groups, means for energizing said indicators as the associated contact devices are operated,

(g) an electrical circuit common to all of said groups and open until all of the indicators in one of said groups have been energized

(h) and *supplementary* means for *indicating* a winning play when all of the indicators in one of said groups have been energized.

There is no question but that in the Gibbs game the electrical circuit referred to in element (g) above is the

win circuit which includes the holding relay R3, and that the “supplementary means for indicating a winning play” of element (h) is either the win light L or the bell 69. This was not disputed by the Plaintiff at the trial. That it could not have been disputed is shown by reference to the Gibbs specification wherein we find element (h) of claim 3, to-wit, “supplementary means for indicating a winning play” (win lamp L or bell 69) mentioned several times as follows:

“additional signal for such
winning play” p. 1, line 9 [R. 303]

“supplementary audible and
visible signal will indicate
the winning play” p. 1, line 68 [R. 303]

“a supplementary indicator
lamp L which is adapted to
be energized only when the
circuit of any one of the
groups of contacts S has
been closed” p. 2, line 78 [R. 304]

“the master indicator L on
each unit * * * will glow to
indicate a winning play” p. 4, line 54 [R. 306]

“thus the bell will ring,
signalling the house oper-
ator who will locate the win-
ning play by its glowing
lamp L” p. 4, line 125 [R. 306]

The win lamp L and signal bell 69 of Gibbs are described in the claims with varying terminology as follows:

Claim 2 refers to a “master signal”

Claim 3 refers to “supplementary means for indicating a winning play”

Claim 5 recites “a signal”

Claims 7 and 8 recite “independent supplementary signal”

Claim 9 recites a “supplementary signal”

Claim 10 has both “supplementary signal” and an “audible signal.”

It is clearly apparent therefore that the “supplementary means for indicating a winning play” called for by the last element of claim 3 must be the full equivalent in structure and function of the win lamp or win bell of Gibbs, and *in addition* must be *supplementary* to the other structure of the claim.

In the new Fawn game there is no win light, win bell, or any other supplementary means for indicating a winning play. Therefore, it follows as a matter of law, applying the well-known doctrine that omission of an element avoids infringement, that the new Fawn game cannot possibly infringe claim 3.

In addition to the reasons above set forth for the non-infringement of claim 3 by the new Fawn game, it is submitted that the new Fawn game further avoids infringement of claim 3 because it omits elements (f) and (g) thereof. However, since the structure alleged by Plaintiff to meet elements (f) and (g) of claim 3 is the

same in both the old and the new Fawn games and since the omission from the new game of the win signal (element h) so clearly avoids infringement of claim 3, a discussion of this additional defense will be deferred until the issue raised by the old Fawn game is treated.

We will first examine the theories advanced at the trial by the Plaintiff concerning the win signal which apparently were sufficiently successful in confusing the issue to cause the trial court to commit error.

3. PLAINTIFF'S THEORIES OF INFRINGEMENT BY THE NEW GAME:

It will be remembered that the *new* Fawn game is in this case *solely at the insistence of Defendant* who was forced to file Interrogatories [R. 5] (to which Plaintiff objected) and a Counterclaim for declaratory relief [R. 12, 13] in order to get the new Fawn game before the trial court.

The Defendant's position then was, and still is, that since he had *never* employed a "win bell," and had *eliminated* his former "win lamp" that *non-infringement* of claim 3 by his new game was so apparent as to make the entry of a decree to this effect merely a routine matter. Obviously he no longer had anything in his Fawn game which responded to the wording:

"supplementary means for indicating a winning play when all of the indicators in one of said groups have been energized." (found in element h of claim 3)

However, Defendant underestimated the tenacity of Plaintiff, who instead of admitting that "white is white" came up with two separate theories to prove that "white is black."

Each of Plaintiff's theories was based on the old expedient of trying to use the same piece of structure several times to thereby meet a number of elements of the claim. This practice is a customary expedient of desperation and has been consistently condemned by the courts. However, even with this false premise, the Plaintiff was not able to build a theory of infringement that meets the plain terms of the claim.

The Plaintiff in casting about for something in the new Fawn game which might somehow be said to be an equivalent of the win lamp or bell of element (h) theorized that since the annunciator lamps in the new Fawn game remained illuminated after the timer had shut down the game, that the circuit which accomplished this could be called the "supplementary means for indicating a winning play."

This argument is obviously fallacious on its face. In the first place the circuit that keeps the annunciator lamps lit does not "indicate" anything, and secondly it is not a "supplementary" means, since it is the self-same circuit alleged by Plaintiff earlier in the claim to meet the terms of element (g). The Plaintiff has not as yet offered to explain just how this circuit of element (g) can be "supplementary" to itself so as to also satisfy element (h). To say that this circuit is the equivalent to the Gibbs signal lamp and bell is to ignore the plain and simple wording of the claim.

The second novel theory propounded by Plaintiff was that because the relay which transferred the power circuit in the winning game made a slight click and caused a momentary flicker of the indicator lights it should be called the supplementary signal means of claim 3. This

argument is of course equally fallacious since the click of the relay and the flicker of the lights is merely an incident of using cheap relays, as admitted by Plaintiff's expert [R. 141-142]. In the first place, the click and flicker do not "indicate" anything to anyone but the individual player, and to him only if he is listening carefully, has been informed that he may expect a click, and is looking at his annunciator at the exact instant he makes a win. Secondly, the relay that is guilty of the click has no function of indicating a win, and if it weren't a cheap variety would not make a click or cause a flicker. Thirdly, even if the click and flicker could be said to be the equivalent of the Gibbs win lamp and bell, the relay causing them is not "supplementary" to the circuit previously claimed, since the relay is the essential part of the circuit previously alleged by plaintiff to meet the terms of element (g).

During the course of the trial the Plaintiff seemed to amalgamate these theories and by the time the trial was over was urging that he found the equivalent of the Gibbs win lamp and bell of element (h) in the transfer relay of the new Fawn game because (1) it was instrumental in keeping the indicator lamps lit as claimed in element (g); (2) because it made a click, and (3) because it caused a momentary flicker in the indicator lamps when their circuit was transferred. Whether or not Plaintiff contends that it takes one or two or all of these factors to make the relay circuit alleged by Plaintiff to meet element (g) become the win lamp and bell of element (h) is not apparent.

In any event, it is submitted that it was clearly error on the part of the trial court to follow these theories of Plaintiff, if they were followed. It is not believed that this court will be similarly misled by such evasive tactics.

D. The Old Fawn Game Does Not Infringe.

Briefly reviewing the construction of the old Fawn game it will be remembered that it comprised a number of game units, each unit comprising a board over which the player repeatedly projected a ball with a catapult. The game board had 24 holes through which the ball could pass, the holes being arranged in two transverse rows of 12 holes each. The ball in passing through any of the holes operated a paddle, one of which was located beneath each hole. Each paddle was part of a switch in an electrical circuit to an indicator light on an annunciator panel for that unit which had 25 lamps arranged in vertical and horizontal rows. The construction of the old Fawn game playing board and annunciator is best seen by the photographs [R. 325, 327 and 329].

Each of the paddles when depressed by the passage of a ball through its aperture released a pin on one of a series of wheels beneath the game board and stayed depressed. Win bars were provided so that when all of the paddles corresponding to any horizontal, vertical or diagonal group of indicator lamps had been depressed, the appropriate win bar would be moved by the wheels, thereby tipping a mercury switch to complete a win circuit which was not connected, *i. e.*, not common, to the lamp circuits. The paddles and other mechanical features of the Fawn game are best seen in the photographs [R. 331-337] and Defendant's colored drawing [R. 527].

The closing of the separate win circuit by mechanically tilting the mercury switch energized a win relay which performed the following functions:

- (a) energized a supplementary signal lamp on top of the annunciator panel;
- (b) disconnected the normal power circuit to the indicator lamps of the winning unit;
- (c) closed an auxiliary power circuit to the indicator lamps on the winning unit, and
- (d) opened the main power switch to disconnect all of the other units, thus stopping the game.

The game was re-started by a re-start lever common to all of the units which lifted all of the paddles back to their pin-engaging position and opened the indicator lamp circuits which had been closed by the depressed paddles. This action also opened the mercury switch, de-energizing the win relay and allowed the main power switch to re-close.

The old Fawn game had no audible signal corresponding to the Gibbs bell 69. Likewise, it did not have any relays R for maintaining the lamps energized. The wiring of the old game is best seen in the wiring diagram [R. 341].

1. CLAIM 3 IS NOT INFRINGED BY THE OLD GAME.

The first and most obvious difference between the old Fawn game and the Gibbs game as defined in claim 3 is the fact that the Fawn game does not include element (f) which recites:

“means for energizing said indicators as the associated contact devices are operated.”

In the game disclosed in the Gibbs specification and described by claim 3 the structure corresponding to the parts of the above element (f) are as follows:

- (1) The “means for energizing” are the relays R and their armature R’.
- (2) “said indicators” are the lamps 1-25, inc.
- (3) The “associated contact devices” are the switches S comprising resilient contacts 53 and 54.

In the Gibbs game when the contacts 53, 54 are momentarily closed by a ball passing through the aperture, they energize the relay R which pulls down its armature R’ which in turn sets up a holding circuit to keep relay R energized to thereby maintain illumination of the lamps 1-25. Since the contacts, 53, 54 are only closed momentarily, it is of course necessary for Gibbs to provide *additional* means, to-wit, the relay R, for maintaining his indicator lamp energized.

In games of this type there are essentially two ways of maintaining the indicator lamps energized. The first and most obvious way is that taught by Nakashima and others in the prior art who keep their contact devices closed throughout the play. No separate or additional means is thus needed to maintain energization of the annunciator lamps.

Another and more complicated way of keeping the annunciator lamps illuminated is to use a switch that only closes momentarily and then to provide separate holding means in the lamp circuit to maintain the lamps energized.

Element (f) above quoted accurately describes the momentarily closed switch and relay method used by

Gibbs for energizing his annunciator lamps and keeping them energized.

From an examination of the Fawn game structure it is seen that the Defendant has adopted the system of Nakashima for energizing his lamps rather than the system of Gibbs. In other words, in Defendant's Fawn game the contacts 51 and 58 remain closed throughout the play, thus obviating the need for additional holding means such as the Gibbs relays R described by element (f) in claim 3. The Defendant has improved the Nakashima system by balancing his paddles 51 so that when they are depressed they will stay depressed by their own weight, thus permitting either the use of a single ball or a plurality of balls in playing the game.

The futility of the Plaintiff's position in attempting to bring the old Fawn game within claim 3 is clearly apparent from the fact that in order to try and read element (f) of claim 3 on the Fawn game he has been forced to again use the contact devices 51, 58 of Faulkner to satisfy the "means" of element (f). However, the contact devices 51, 58 which Plaintiff now says constitute the "means" of element (f) are the same contact devices recited in element (d) and again recited in element (f). In other words, if we analyze Plaintiff's position with respect to element (f) we find that in attempting to read this element on the Defendant's game he has reconstructed it to read as follows:

"means for energizing (contacts 51, 58) said indicators as the associated contact devices (51, 58) are operated."

It is obvious, therefore, that the Plaintiff has argued himself into the absurdity of contending that the means which operate as the associated contact devices are operated, are the contact devices themselves.

It is therefore apparent that element (f) of claim 3 is broad enough to read on Nakashima as previously discussed in the section dealing with invalidity, but still is not broad enough to include the Defendant's balanced switch which stays closed throughout the play and therefore obviates the necessity of having separate energizing means such as Gibbs relays R.

If, therefore, claim 3 is construed broadly enough to read on Defendant's switch, then of necessity it must be invalid as likewise and more clearly reading on the Nakashima patent.

Additionally, it is seen that the old Fawn game omits element (g) of claim 3 which reads as follows:

an electric circuit *common* to all of said groups and open until all of the indicators in one of said groups have been energized.

Referring to Exhibit B [R. 371] it is clearly seen that in the Gibbs game the electrical circuit referred to in element (g) is the win circuit comprising relay R3, lead 114' and lead 98, all of which are colored in red, which win circuit is electrically *connected to* all of the segmental circuits which are made up by closure of the various armatures R'. In Exhibit B three of these segmental circuits are shown in colors, a typical horizontal circuit being shown in red at the top of the diagram, a typical vertical light circuit shown in blue and a diagonal circuit

shown in yellow. It will be seen that all of these segmental circuits, red, blue and yellow, are *electrically connected* at their right end to lead 98 of the win circuit and at their left side to power lead 86. The win circuit is therefore clearly *common* to all of the group circuits and is held open until one of these group circuits has been completed and all of the indicators of that group are energized.

An electrical circuit can only be *common* to another electrical circuit, of course, when it is *connected to or connectable therewith*. Consequently, the phraseology in claim 3, a “circuit *common to all* of said groups” which was suggested by the Examiner, can only refer to a situation such as shown in Gibbs where the win circuit is *electrically connected* to a plurality of other circuits.

By reference to Defendant’s Exhibit I [R. 533] it will be seen that in the Fawn games there are no segmental group circuits as in the Gibbs game. It will be further seen that the Fawn win circuit shown in red in Exhibit I [R. 533] is separate and distinct from any circuit associated with the indicator lamps and is operated by mechanical movement of the mercoid switch M. It is submitted, therefore, that element (g) of claim 3 is totally lacking in both the old and new Fawn games.

In summary, we find that neither the old nor the new Fawn games contain structure or circuits which meet elements (f) or (g) of claim 3, and that for these reasons neither the old nor the new Fawn games infringe claim 3.

2. CLAIM 6 IS NOT INFRINGED BY THE OLD GAME:

As previously mentioned, claim 5 covers the interconnection of a group of the Gibbs game units defined by claim 3. Since as pointed out in the preceding section the old Fawn game does not infringe claim 3, a group of the old Fawn games hooked together in the manner taught by Chester or any of the other prior competitive games cannot therefore infringe claim 6 which merely recites a group of the claim 3 units.

There are of course various specific ways in which a group of game units can be electrically interconnected, as demonstrated by the fact that each of the circuits of the prior art patents is slightly different from the other and has a few features specific to it alone.

A comparison of the simplified Gibbs circuit shown in Exhibit G [R. 529] with the simplified Chester circuit shown in Exhibit H [R. 531] shows the close similarity and minor differences between these two circuits.

In both of these diagrams the win circuit has been colored red, the auxiliary circuit which keeps the winning game illuminated is colored purple, and in green is shown the transfer circuit which de-energizes all of the non-winning units. It will be noted that the red, green and purple circuits of Gibbs and Chester are substantially identical with the one exception that the red win circuit of Chester is closed by the mechanical operation of win switch 30, 51 whereas Gibbs' red win circuit is closed by the consecutive closing of the relay armatures R'. In other words, while the Gibbs and Chester circuits accomplish substantially the same purpose, they do so in a slightly different manner.

Now comparing the Chester wiring diagram Exhibit H [R. 531] with the old Fawn game wiring diagram Exhibit I [R. 533] it will be seen that the Fawn game circuit is practically identical with Chester and much closer thereto than it is to the Gibbs circuit. In both Chester and Faulkner we have the red win circuit *mechanically* closed by the operation of a mechanically operated win switch. In Chester it is the win switch 51 while in Faulkner it is the mercoid switch M. In each case the operation of the win switch energizes a coil which in Chester is represented by numeral 53 and in Faulkner by numeral 98. In Chester there are three contacts or switch blades operated by this coil whereas in Faulkner there are only two, but the over-all function of these switches is exactly the same.

By the closing of his triple blade switch Chester first energizes his coil R2 through the left-hand switch blade which sets up a self-holding circuit from main power line C up through the left-hand switch blade to coil 52 and thence back through purple horizontal leads to by-pass coil 62 which connects with main power line 61. In Faulkner this same operation is accomplished by the switch blade 84 moving over to close its purple circuit which by-passes the main power shut off and keeps the winning game energized.

Movement of the middle switch blade of Chester to the left energizes the blue win lamp circuit which connects through the purple circuit back to main 61. The same is true in Faulkner where the win lamp 22 is energized by current flowing through lamp 22, switch blade 84 and the purple transfer circuit.

The third function performed by the relays 53 and 52 of Chester is to set up a separate green circuit which energizes main line solenoid 62 which opens the main switch, thus killing main line A and all competing games.

Similarly, in the Fawn game, the left-hand switch blade sets up the green transfer circuit which energizes coil 106, opens switch 112, thereby breaking the circuit in main solenoid 111 and opening main switch 110 to kill main line 78 and all of the competing units.

It is thus clearly seen that the Defendant Faulkner instead of appropriating the Gibbs circuit as alleged by Plaintiff merely adapted the Chester circuit to his particular apparatus, *i. e.*, he interconnected a number of his individual game units of the Nakashima type in exactly the same manner as taught by Chester.

Consequently since the individual units of Faulkner do not infringe claim 3, a bank of them connected as taught by Chester cannot infringe claim 6 which recites a plurality of the claim 3 units.

3. CLAIMS 7 AND 8 ARE NOT INFRINGED BY THE OLD GAME:

Since, as we have just seen, claim 6 is not infringed by the old Fawn game, its dependent claims 7 and 8 of course are not infringed for the same reasons.

Claim 8 is additionally not infringed because its element (g) calls for

“means under the control of an operator for opening and closing the circuits of all of said units simultaneously at will.”

This of course refers to the main line switch 68 in the Gibbs patent which is entirely different from the structure in the Fawn game, for in the Fawn game the main power switch is not manually operated.

4. CLAIMS 9 AND 10 ARE NOT INFRINGED BY THE OLD GAME:

Claim 9.

As previously shown, claim 9 is void for failing to define the invention described in the Gibbs specification. The wording that creates this situation is doubly unfortunate for Gibbs in that it not only renders the claim void but also renders it clearly not infringed by Defendant.

Referring again to our claim analysis of claim 9 [R. 368, 369, 270], we find that elements (e) and (f) state as follows:

(e) means for holding said signal circuit open until all of the indicators of any group on *each* of said units have been energized, and

(f) for closing said signal circuit when *all* of the indicators of any *unit* have been energized.

Obviously, these elements of claim 9 do not read upon the old Fawn game since in the old Fawn game the win circuit is operated when only a *portion, i. e., a group*, of the indicators of any unit have been energized.

Mr. Gibbs in his desire to cover the whole field of automatic Bingo games evidently relied on claims 6, 7 and 8 to cover the game which he disclosed in his patent, and wrote claims 9 and 10 to cover another class of games. In so extending the scope of his patent by directing claim

9 to a type of game where the signal circuit is closed in response to energization of *all* the indicators on the winning unit, Gibbs used wording which fails to cover either his own game or the old Fawn game. It is axiomatic that each claim in a patent must stand on its own feet for the general public is entitled to take each claim at its face value. All members of the public are entitled to read claim 9 of the Gibbs patent or any other claim in an issued patent and to rely on what it says. In this case, the claim clearly states that it covers only an apparatus which has

“means for closing said signal circuit when *all* of the indicators of any *unit* have been energized.”

The general public, including this Defendant, is entitled, therefore, insofar as this claim is concerned, to make an apparatus having a signal circuit which is closed when *only a portion* of the lamps in a winning game are energized.

The Plaintiff will undoubtedly urge that this claim should be judicially reconstructed to cover a plurality of his individual game units as defined in claim 3. However, this contention can avail Plaintiff nothing since if the Court should so construe claim 9, then it is nevertheless avoided by the old Fawn game since, as has been pointed out, the old Fawn game does not infringe claim 3.

Claim 10.

Claim 10, being dependent upon claim 9, is not infringed for the same reasons that claim 9 is not infringed.

Additionally, claim 10 is clearly not infringed by either of the Fawn games since there is no “audible signal” in

either of the Fawn games whatsoever. Claim 10 adds to claim 9 the following:

“an *audible signal commonly connected* with all of said units and adapted to be operated upon the closing of the supplementary signal circuit of any of said units.”

It is therefore clearly apparent that no matter what construction is placed upon claim 9 that claim 10 cannot possibly be infringed by either of the Fawn games.

E. THE MATTER OF DERIVATION.

It is fundamental patent law that a patentee's invention is measured by the scope of his claims. He is entitled to that which he claims and in some instances mechanical equivalents thereof, *but nothing more*. The *only reason* for having claims in a patent is to inform the patentee and the public of the extent of the monopoly granted so that the members of the public may be guided thereby in making further advances in the art without infringing upon the patentee's monopoly.

As a matter of law, therefore, any member of the public may, and should upon entering an art, read the claims of all patents in that art so that he will know what he can and cannot do in utilizing the fund of common knowledge in said art.

To say therefore that a person who has built a device which is outside of the claims of a patent, is nevertheless guilty of infringing that patent, merely because he read the patent or happened to see one of the patentees devices on the open market prior to building his own machine, is to do violence to the fundamental statutory

and decisional law pertaining to patents. Yet this is exactly what the trial court ruled in this case. This ruling is supposedly supported by Finding of Fact No. 13 [R. 38] which however is directly contrary to the evidence brought forth at the trial.

It is appellant's position herein that the question of derivation has no part in the issue of infringement. If it involves the use of information obtained by the Defendant as the result of his employment by the patentee or other confidential relationship, it may be relevant to the issue of damages only.

In this case of *Gibbs v. Faulkner* there is no showing whatsoever that the Defendant or any of his agents or employees had any connection whatsoever with the Plaintiff or Plaintiff's games, or were even aware of the Plaintiff, his games or his patent prior to the start of this suit. The actual facts as shown by the testimony are as set forth in Appellant's proposed Alternate Finding No. 13 [R. 23].

Defendant objected [R. 81] to the introduction of any evidence relative to the Loeff game, but the objection was overruled and Mr. Wiser, one of the Defendants in the case of *Gibbs v. Loeff et al.*, was permitted to testify concerning the Loeff game. It will be remembered of course that the *Gibbs v. Loeff* case was settled by giving Gibbs a consent decree for which Gibbs gave to Loeff and Wiser the license for the City of Long Beach. Therefore, the Defendant herein is a competitor of Messrs. Loeff and Wiser, and the testimony of Mr. Wiser is obviously biased.

However, by Mr. Wiser's own testimony there was no copying either by him or Mr. Loeff or this Defendant of the Gibbs apparatus. (See Appendix, p. 14.)

It is apparent from Mr. Wiser's testimony as follows:

- (1) He saw a Gibbs game in 1937 and became familiar with the method of play but did not see inside of the game.
- (2) In 1940 three years later Mr. Wiser constructed a game for himself and Mr. Loeff.
- (3) Six years later in February, 1946, Mr. Wiser and Mr. Loeff were sued by Gibbs for alleged infringement of the Gibbs patent.
- (4) In February, 1946, for the first time Mr. Wiser examined a copy of the Gibbs patent and became familiar with the circuits therein disclosed.
- (5) Mr. Wiser has an indirect interest in this present suit in that he and Mr. Loeff are the licensees of Gibbs for the City of Long Beach and this Defendant is their only competitor.

There is not one shred of evidence in the record to indicate that the Fawn game bears the slightest resemblance to the Loeff game except in outward appearance and the method of play. There is nothing in the record as to how the Loeff game is constructed or how the circuits are arranged therein. There is nothing in the record to show that there is any similarity between the Loeff game and the Gibbs game or any infringement of the Gibbs patent by the Loeff game. The Plaintiff seeks to draw an inference of infringement by the bare fact that Loeff and Wiser settled their suit with Gibbs by giving a consent decree and taking a license for the City of Long Beach.

Obviously, this inference can have no weight since there is nothing in the record to indicate but that it was materially to Loeff's advantage to pay Gibbs a nominal

amount for an exclusive license, *provided Mr. Gibbs started suit against Mr. Faulkner and closed up his business*. The logic of such an arrangement is well shown by the fact that within a very short time after the *Gibbs-Looff* case was settled, Mr. Gibbs filed suit against the only two competitors of Mr. Looff, to-wit, Mr. Hicks, *et al.*, and Mr. Faulkner. As mentioned, Mr. Hicks capitulated without a fight,—Mr. Faulkner is still fighting.

III.

Conclusion.

It is submitted that the Decree of the lower court should be reversed on all points and in particular, that the Gibbs patent be held invalid as to all of the claims in suit and not infringed by either of the Fawn games. It is believed that the Defendant-Appellant has successfully demonstrated that:

1. Claim 3 of the Gibbs patent is anticipated by the prior patent to Nakashima and is therefore invalid for lack of novelty.
2. Claims 6, 7, and 8 are anticipated by the prior patent to Prina and are therefore invalid for lack of novelty.
3. Claims 9 and 10 of the Gibbs patent are invalid for claiming an invention other than the one disclosed in said patent.
4. All of the claims in suit are invalid for lack of invention.
5. The new Fawn game does not infringe claims 3, 9 or 10 of the patent in suit.
6. The old Fawn game does not infringe claims 3, 6, 7, 8, 9 or 10 of the patent in suit.

This case should therefore be remanded to the lower court with instructions to dismiss the Complaint herein and award judgment to Defendant on his Counterclaim on the grounds of invalidity of the patent in suit and non-infringement thereof, and that Defendant-Appellant be awarded his costs of suit and attorneys' fees incurred in the lower court and his costs and attorneys' fees incurred in this appeal.

Respectfully submitted,

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APPENDIX.

Construction and Operation of Gibbs Game.

As previously mentioned, the Gibbs patent discloses an electrified Bingo game comprising a plurality of game units electrically connected together. Referring to the drawings of the Gibbs patent [R. 295-301], it is seen that each of said game units includes a table T having a horizontal game board C provided with a plurality of apertures or pockets 26-50 through which a ball B is adapted to drop when it is rolled across the board C. At the rear of the game board C is an annunciator panel A having a plurality of indicator lights numbered 1-25 thereon. The indicator lights and the apertures are arranged in the same order, to-wit, five rows of five each, and each indicator lamp is connected to a switch S comprising resilient contacts 54 and 55 disposed beneath its corresponding aperture. This general organization is seen best in Figs. 1-4, inclusive, of the patent.

As seen diagrammatically in Figure 6 of the patent but best in Exhibit B [R. 371] each of the switches S has associated therewith a relay R having an armature R' provided with a plurality of pairs of contacts one of which is numbered 99 and the other 113. The wiring of the game is such that when a ball is dropped through one of the apertures 1-25, as for example aperture No. 1 which is illustrated in the upper left-hand corner of Fig. 6, the switch S underneath this aperture is momentarily closed, completing a circuit through its relay R. Energization of the relay R pulls its armature R' down so that all of

its contacts engage the stationary contacts immediately therebelow. In particular the armature contacts 99 bridge stationary contacts 88 and 88' and armature contacts 113 bridge stationary contacts 112 and 112'. This action is also seen in Figure 7 of the Gibbs patent.

Since the switches S are only closed momentarily when the ball B passes thereover, it is necessary to provide additional means to keep the indicator lamps energized so that the player will at all times know the progress he is making in the game. This function is performed by the relay R since when the armature R' bridges the contacts 112 and 112' it completes a holding circuit through the terminal 104 to keep the relay R and its associated indicator lamp energized after the switch S opens.

In a competitive game it is of course desirable to immediately indicate the fact of a win to the players and operator. It is also desirable, and was well known at the time Gibbs entered the field, that immediately upon one player making a win, the other game units should be disconnected to prevent further play by the other players. This purpose is accomplished in the Gibbs game by having the armatures R' complete portions of separate potential win circuits, horizontal, vertical or diagonal so that when the fifth indicator in a line has been energized the win circuit will be complete.

For example, when the contacts 99 of indicator No. 1 bridge contacts 88 and 88' the circuit is completed from main lead 87 over to fixed contact 90 of indicator No. 2. If then a ball drops through the aperture corresponding

to indicator No. 2 its armature R' is pulled down by its relay R, causing its contacts 99 to bridge fixed contacts 90 and 90', thus setting up the second portion of the top horizontal win circuit over to fixed contact 92. When armature contacts 99 of indicators, 3, 4 and 5 bridge their respective fixed contacts the horizontal win circuit is completed through fixed contact 96' to the other main lead 98.

This system of sequentially completing progressive segments of a master circuit has of course long been known in the art, as shown in the McGregor patent [R. 411-421] issued in 1918.

It is seen that when the top series of five indicator have been energized by their respective relays R the win circuit shown in red in Exhibit B [R. 371] is made. This red win circuit passes through a holding relay R3 and also energizes a win lamp L disposed on top of the annunciator panel A of the winning game unit. Current passing through relay coil R3 causes its armature R5 to move downwardly into engagement with its three sets of fixed contacts 119, 121 and 112, thus establishing the auxiliary circuit shown in green in Exhibit B which energizes the coil of feed relay R2 and transfers power to the previously dead line 60. This rings the win bell 69 and energizes the feed relays R2 in all the other game units.

Whenever feed relay R2 is energized, its armature R4 is pulled down, thus breaking the main circuit for that game unit shown generally by brown lines in Exhibit B.

An auxiliary circuit is provided in the winning game unit only, between fixed contact 119 of holding relay R3 and line 86, as shown by the purple lines in Exhibit B. In other words, holding relay R3 when energized not only transfers power to the previously dead line 60 to energize all of the feed relays R2 and disconnect all of the units except the winning unit, but it also transfers power to an auxiliary circuit in the winning game unit so that its lights will stay lit until the operator pulls the main switch to disconnect all units.

It will be seen, therefore, that whenever a win circuit is completed, for example, a horizontal line of five as illustrated in red in Exhibit B, or a vertical line of five as illustrated in blue, or a diagonal line of five as illustrated in yellow in said exhibit, the holding relay R3 of that winning unit is energized, with the result that the win light L on that unit is illuminated, bell 69 is caused to ring, and the feed relay R2 on each of the competing units is energized, thus disconnecting all of the competing units and preventing further play thereon.

Construction and Operation of Old Fawn Game.

The Defendant's old Fawn game is illustrated and described in detail in Exhibit 2 [R. 309-341]. A less detailed but more graphic description of the old Fawn game is found in the testimony of Defendant's expert, Mr. Harold Mattingly, commencing at R. 180. Mr. Mattingly's discussion refers to the photos and diagram of Exhibit 2, physical Exhibit E comprising a mechanical mechanism taken from one of Defendant's Fawn games, and Exhibit F comprising two colored schematic drawings [R. 527] of the mechanism Exhibit E. Reference is made to said exhibits and Mr. Mattingly's testimony for a detailed treatment of Defendant's old Fawn game, the essential features of which will be described here for convenience. The numerals used in the following description refer to the photographs and wiring diagram in Exhibit 2 [R. 325-341, incl.].

Each of the old Fawn game units comprises an inclined playing board 25 provided with a plunger 26 designed to propel a metal ball 27 across the board and into one of a plurality of holes 31, 32 arranged in two transverse rows across the board instead of in five rows of five as in the Gibbs patent.

At the rear of the board 25 is an annunciator panel 21 having 25 indicator lights thereon, each of the lights corresponding to one of the holes in the playing board. The lights on the annunciator panel 21 correspond in number but not in arrangement with the holes upon the playing board and are energized when the ball 27 passes through the appropriate hole.

Immediately below each of the holes in the playing board is a switch mechanism comprising a paddle 51 and a pair

of spring contacts 58 engaged by the paddle when it is depressed. The paddles 51 are mounted so as to tilt downwardly when the ball 27 is dropped upon the paddle after falling through the hole. Once the paddles are depressed they stay depressed by virtue of their own weight and slight friction from their engagement between the pair of switch contacts 58, thereby maintaining their respective lamps illuminated.

At the rear of the mechanism Exhibit E and as illustrated in Exhibit F, there is a series of small wheels 61 mounted on a common shaft, each one of which has a pin 64 extending radially upwardly to normally engage behind the rear end of a corresponding paddle 51. Consequently, when the forward end of the paddle is depressed by the ball dropping thereon the rear end of the paddle is raised, releasing the pin 64 and its wheel 61. As the ball is dropped through other holes on the playing board, additional paddles will have their rear ends raised to permit release of their corresponding wheels to eventually set up a mechanical win mechanism. When the ball is dropped through the fifth hole of a series corresponding to a line of five lights on the annunciator, a win bar is pulled forward by a spring causing mercury switch M to close.

Referring particularly to Exhibit F [R. 527], the upper figure illustrates the position of the various mechanical parts of the Fawn game prior to the operation of any of the paddles. The paddles 51 are colored yellow and it will be seen that their rear ends act as stops against which the pins 64 of the wheels 61 (both colored red) bear, and as long as the paddles remain with their rear ends down, the wheels are prevented from rotation [R. 184].

Extending across in front of all of the wheel pins is a win bar colored green, the lower end of which carries the

small glass-enclosed mercury switch M. As the forward ends (the far ends in Exhibit F) of the paddles are moved downwardly, their rear ends will assume the position shown in the lower figure in Exhibit F [R. 527] where it will be seen that the rear ends of the first five of the paddles have been raised and have released the wheel pins previously held by them. Release of the fifth red pin permits a spring-operated cross bar colored blue to be pulled forwardly to move all of the vertical red pins against the green win bar which is thereby rocked forwardly sufficient to close the mercury switch M.

It will be understood that the blue win bar cooperates only with the five wheels which correspond to the row of five lights across the top of the annunciator, this being used for illustrative purposes. Since twelve win light combinations are possible, twelve cross-bars are provided, one for each possible combination of five wheels and lights. Selector pins are also provided which need not be described here.

One of these additional cross-bars, shown in brown in Exhibit F, is for producing one of the possible vertical combinations and extends across the machine to engage the pins on the wheels which correspond to these vertical lights. When the paddles for this vertical line of lights have released their pins the brown bar will swing forward and in so doing will move its five pins on the wheels corresponding to its particular line of vertical lights into engagement with the green win bar to swing the same forward and close the mercury switch M.

A third cross-bar which has been colored purple extends across all of the wheels and engages pins that will be on those wheels which are associated with a diagonal line of lights so that when those wheels are released by operation

of their paddles the purple cross-bar will swing forward to move the green win bar forward to close the mercury switch.

As illustrated in the wiring diagram Fig. 9 [R. 341] and as better seen in Exhibit I [R. 533] the normal main line feed circuits are numbered 77 and 78. Each of the annunciator lights is connected to these mains through its respective switch 58 so that as the switches 58 are closed a circuit is made through the lines colored brown in Exhibit I, to-wit, from main 77 through leads 92, 91, 90, a switch 58 up to the annunciator light, back down through leads 85, switch arm 84 and lead 83 to main 78. A similar circuit is made for each of the annunciator lights as its switch 58 is closed.

When the fifth annunciator light in a row has been illuminated by the closing of its switch 58 the wheels of the five illuminated lights are rotated and permit rotation of the win bar as previously described to tilt the mercury switch M thus energizing the circuit outlined in red in Exhibit I. This circuit extends from line 92 through lead 93, the switch M, leads 99 and 121, relay coil 98, leads 122 and 100, through switch arm 84 and lead 83 to the main line 78. Energization of the relay coil 98 by completion of the red win circuit pulls both blades of the switch S over to the left, causing the right blade 84 which previously was connected with lead 83 to be transferred to terminal 84' which completes the purple circuit down through leads 101, 103, 104 and 114 back to main line 78. This purple circuit acts as a transfer circuit to maintain power to the annunciator board of the winning game.

Movement of the left-hand blade 109 of switch S over to the upper end of lead 108 sets up the green circuit

comprising leads 108, 107, relay coil 106 and lead 114 back to main line 78. Energization of this green circuit and consequently relay coil 106 pulls armature 112 to the right, opening the yellow circuit of which relay 111 is a part. Interruption of the yellow circuit and consequent de-energization of the coil 111 permits main switch 110 to be pulled to the left by a spring (not shown) thereby breaking the circuit to main power line 78, and cutting off current to all of the non-winning game units. However, since the purple transfer circuit has been completed which by-passes main line 78 beyond its switch 110, the lights on the winning board stay illuminated.

When the red win circuit on the old Fawn game was completed by movement of the mercury switch M, a signal light 22 (not present in the new Fawn game) at the top of the annunciator of the winning game unit was illuminated to indicate a win on that unit. The red win circuit, being fed through the purple transfer circuit, the win light remained on until the operator by movement of the main control handle moved the switch S back to its original position, thus breaking the purple circuit, re-energizing the main feed relay 111 and closing the main line switch 110, restoring all connections to their original form.

Construction and Operation of New Fawn Game.

The playing board, annunciator panel and mechanical parts of the new Fawn game are the same as in the old Fawn game, utilizing the same paddles, wheels and win bars to operate a mercury switch M when a win has been accomplished.

However, the electrical circuits and methods of play are entirely different in the new Fawn games.

The old Fawn game (like the Gibbs game) was competitive since the players played against each other and when a player had effected a win on his game unit the game units of all the other players were immediately disconnected, thereby stopping the game. The new Fawn game, on the other hand, is provided with a timing clock so that all players play for the same length of time and all may win if they are sufficiently skillful. Even though one player makes a win, none of the other games is disconnected until the allotted time has elapsed. In other words, the new Fawn game is non-competitive in that each player is individually playing against the clock instead of against the other players.

The timing mechanism of the new Fawn game and the circuits connecting it to the game units are shown in Exhibit J [R. 535] in which the upper portion of the diagram is a reproduction of two of the game boards illustrated in the wiring diagram [R. 341 of Exhibit 2] the circuits above the main power line 77 being the same as before except that a single bladed switch 84 has been substituted for the two bladed switch S of the old game. The single blade of switch 84 functions the same as the blade 84 of the old switch S and sets up a purple transfer

circuit, but the auxiliary green circuit of the old game shown in Fig. 9 [R. 533], is omitted.

The lower portion of the diagram Exhibit J [R. 535] shows the wiring for the timer and how it cooperates with the individual game units to shut down the game only when the pre-determined time has elapsed.

It will also be seen that there are *no win lights* on the annunciator panels as in the old game.

It should also be noted that there is one error in Exhibit J, to-wit, the main line switch 110 is shown in its closed position, whereas, with the timing mechanism in the position shown, the switch 110 would be open.

In the old Fawn game the main line switch 110 was controlled by the operation of the relay 106 which was energized immediately upon the making of a winning combination on any of the game units to thereby de-energize relay 111 which normally holds the main switch 110 closed. In the new Fawn game, however, the relay 111 is under the control of an auxiliary relay 151 which is in turn controlled by the time clock mechanism which is shown at 200 on Exhibit J.

Another distinctive feature of the new Fawn game circuit is the addition to the re-set bar or handle 207 of switch 208 which is momentarily closed when the re-set bar is operated to re-set all of the switch arms of the game units at the end of a game.

As in the old Fawn game, the operation of the mercury switch M in response to movement of the wheels and win bars underneath the playing board energizes the relay 98 which pulls the switch arm 84 over from its normal contact with lead 83 to terminal 84', thus shifting the power

circuits on the winning board away from the power line 78 and onto a subsidiary power line 78' which extends from the source of power on the far side of the power switch 110. This transfer circuit colored in purple which is operated in response to the completion of the red win circuit merely insures that each game unit on which there is a winner before the time clock shuts down the play will have its annunciator board remain illuminated at the close of the play.

In operation, the new Fawn game is started by the operator moving the re-set handle 207 downwardly to mechanically restore all of the switch blades and all of the paddles on all of the machines to operative position and at the same time close the switch 208 which energizes relays 161 and 151. Relay 151 then closes its contacts 150 to thereby establish a circuit which energizes the main relay 111 to pull the main switch 110 into the closed position shown in Exhibit J.

Relay 161 is likewise energized by the closing of the switch 208 so that its contacts 162 are closed and in that way supplies current around the switch 208 to keep the relays 161 and 151 energized even though the re-set handle is allowed to return to its normal position.

The timer itself consists of a box in which is mounted a disc in the form of a cam identified by the reference numeral 201, the cam having a notch 203 at one point in its periphery in which rides a finger 204 pivotally mounted and having a mercury switch 205 operable thereby.

As the timer cam 201 is rotated by the motor 200 the notch in the cam is moved from under the finger 204 which is thereby lifted to close switch 205 which continues the

energization of the main power switch 111 for the time period required for the cam to make one complete revolution and re-align the notch 203 under the end 204a of the finger 204. The switch 205 is thereby re-opened and the circuits to relays 151 and 161 are opened to de-energize the main power switch coil 111.

The timing motor is connected to the cam by means of a friction drive so that by operating a handle 107 the friction disc 202 can be moved toward the center of the cam 201 or away from it, thereby changing the timing period by changing the speed at which the cam 201 is rotated.

During the play a win may be made on any of the game units and the making of a win does not affect the operation of the rest of the games which continue to operate during the allotted time. Consequently, there may be two, three or more winners during one game period.

The re-set handle 207 is on a long shaft that extends underneath all of the games in a bank, which shaft is connected at each game unit to a re-set lever on the mechanical mechanism of that game unit so that when the re-set shaft is rotated the individual game re-set levers are pulled back, thus forcing all of the paddles back to their original positions and pulling the win bars back to their original positions behind all of the radial pins on the little wheels.

As previously mentioned, the new Fawn game has no win lights at the top of the annunciator board nor any other "supplementary means" for indicating a win.

Furthermore, the new Fawn game is not a competitive game, and the trial court so held.

Testimony Re Derivation.

The following testimony [R. 85] is illuminating on the subject of what if any copying Mr. Wiser did of the Gibbs game at Santa Monica:

“Q. When you went over to Santa Monica to see the Fascination Game did you play the game? A. Yes.

Q. Did you examine it inside, the wiring diagrams? A. No.

Q. You did not see inside of it? A. No.

Q. What you set out to do was to copy the method of play of that game? A. Yes.

Q. Was that game your original construction as to the circuits involved in the inside? A. Yes.

Q. You designed all the circuits, did you? A. Well, not myself; myself and the men that worked with me.

* * * * *

Q. Was your playing board similar to the playing board of Mr. Gibbs' machine in Ocean Park? A. Only in the respect that it had the 25 holes, numbered holes.

Q. I see. A. That were correspondingly indicated on the annunciator board.

Q. When did you first become familiar with the circuit in the Gibbs patent? A. When I found his patent in the—let's see—when I went down to the library and looked his patent up in the records.

Q. When was that? A. That was in February, 1946.

Q. What was the occasion of your interest in the Gibbs patent? A. Being associated with Mr. Loeff

in the operation of the Lite-A-Line games it was to my interest to investigate Mr Gibbs' Patent.

Q. That was when he sued you and Mr. Loeff, was it not? A. Yes.

Q. Were you a party defendant in that action? A. Yes.

* * * * *

Q. By Mr. Fulwider: Are you still in partnership or associated with Mr. Loeff in the operation of the Lite-A-Line Game in Long Beach? A. Yes.

Q. Do you have a financial interest in the outcome of this litigation? A. No.

Q. You do have an interest in this, that you are interested in minimizing competition in Long Beach, are you not? A. Yes.

Q. If this Defendant were enjoined that would inure to the benefit of your business, I assume? A. Yes."

POINTS AND AUTHORITIES.

Law Point 1.

THE CLAIMS MEASURE THE INVENTION.

- (a) “. . . the claims measure the invention. They may be explained and illustrated by the description. They cannot be enlarged by it.”

Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 419.

- (b) “The scope of every patent is limited to the invention described in the claims contained in it, read in the light of the specification. These so mark where the progress claimed by the patent begins and where it ends that they have been aptly likened to the description in a deed, which sets the bounds to the grant which it contains. It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is, the exclusive use of which is given to the inventor by the grant provided for by the statute.”

Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U. S. 502, 510.

- (c) “In view of the statute, the practice of the Patent Office, and the decisions of this Court, we think that the scope of Letters Patent should be limited to the invention covered by the claim, and that though the claim may be illustrated, it cannot be enlarged by the language used in other parts of the specification.”

Railroad Co. v. Mellon, 104 U. S. 112, 118.

- (d) "The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim, it can never be made available to expand it."

McClain v. Ortmyer, 141 U. S. 419, 432, quoted with approval in *Rip Van Winkle Wall Bed Co. v. Murphy Wall Bed Co.*, 1 F. (2d) 573, 679 (C. C. A. 9).

Law Point 2.

THE CLAIMS MUST BE DEFINITE, UNAMBIGUOUS AND READ ON THE PATENTEE'S OWN STRUCTURE.

- (a) "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

White v. Dunbar, 119 U. S. 47, 51-52.

- (b) "The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it leaves no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. The genius of the inventor should not be restrained by vague and indefinite descriptions of claims in existing patents, from the salutary and necessary right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the

patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent."

Merrill v. Yeomans, 94 U. S. 568, 573-74.

- (c) "All claims are required to be definite so that the public may know what they are prohibited from doing during the term of the patent, and what they are to have at the end of the term, as a consideration for the grant. *Brooks v. Fiske*, 15 How. (56 U. S.) 212, 214-15;"

Walker on Pats., Deller's Ed. 1233, 4.

- (d) "The statutory requirements relevant to particularity in the descriptions and claims of Letters Patent are conditions precedent to the authority of the Commissioner of Patents to issue such documents, and if such document is issued, the description or claims in which do not conform to these requirements, then that document is void."

Walker on Pats., Deller's Ed. 1273.

- (e) "The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery,' is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them."

Rip Van Winkle Wall Bed Co. v. Murphy Wall Bed Co., 1 F. (2d) 673, 679 (C. C. A. 9).

quoting with approval from:

McClain v. Ortmyer, 141 U. S. 419, 423.

Law Point 3.

WHAT IS NOT CLAIMED IS DEDICATED TO THE PUBLIC.

- (a) "It is a well-known rule of patent law that anything disclosed but not claimed is dedicated to the public. This principle . . . may be deemed to be elementary."

Rip Van Winkle Bed Co. v. Murphy Wall Bed Co., 1 F. (2d) 673, 679 (C. C. A. 9).

- (b) "Of course, what is not claimed is public property."

Mahn v. Harwood, 112 U. S. 354, 361.

- (c) "The patentee by claiming what he regards as new, disclaims or dedicates to the public the remaining parts. *The Corn-Planter Patent*, 23 Wall. (90 U. S.) 181, 182; *Rozell v. Lindsay*, 133 U. S. 97, 101."

Stedman on Patents 294.

Law Point 4.

THE PATENTEE IS BOUND BY HIS CLAIMS.

- (a) "As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public."

Keystone Bridge Co. v. Iron Co., 95 U. S. 274, 279.

- (b) "Since the inventor must particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery, the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it different from what it is."

Howe Mach. Co. v. National Needle Co., 134 U. S. 388, 394.

- (c) "Where a patentee has narrowed his claim, in order to escape rejection, he may not 'by resort to the doctrine of equivalents, give the claim the larger scope which it might have had without the amendments, which amount to disclaimer."

Smith v. Magic City Kennel Club, 282 U. S. 784.

Law Point 5.

OMISSION OF AN ELEMENT AVOIDS INFRINGEMENT.

- (a) "A defendant who omits one of the material elements of the combination does not infringe."

Dunkley v. Central Calif. Canneries, 7 F. (2d) 972, 975 (C. C. A. 9),

quoted with approval in *Magnavox Co. v. Hart & Reno*, 73 F. (2d) 433, 444 (C. C. A. 9).

- (b) "Omission of one element or ingredient of a combination covered by any claim of a patent, averts any charge of infringement based on that claim."

Walker on Pats., Deller's Ed. 1695.

- (c) "If the defendant omits one or more of the material elements which make up the combination, he no longer uses the combination; and it is no answer to say that the omitted elements are not essential, and that the combination operates as well without them as with them."

Magnavox Co. v. Hart & Reno, 73 F. (2d) 433, 444; 23 U. S. P. Q. 211, 222 (C. C. A. 9),

quoting with approval from the C. C. A. 9 case of *Wilson & Willard Mfg. Co. v. Union Tool Co.*, 249 Fed. 729, 731.

- (d) "A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible in any case of alleged infringement. *Vance v. Campbell*, 1 Black (66 U. S.) 427, 430; *Yale Lock Co. v. Sargent*, 117 U. S. 373 (1886);"

Walker on Pats., Deller's Ed. 1697.

Law Point 6.

ALL ELEMENTS SPECIFIED IN A CLAIM ARE MATERIAL.

- (a) "And where a claim for a combination specifies a certain element as entering into it, such element is thereby made material and the court cannot declare it immaterial."

Walker on Pats., Deller's Ed. 1234.

- (b) "The claims of the patents sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination, either directly by the language of the claim, or by such reference to the descriptive part of the specification as carried such element into the claim, he makes such element material to the combination, and the court cannot declare it to be immaterial. It is his province to make his own claim and his privilege to restrict it. It is be a claim to a combination, and be restricted to specified elements, all must be regarded as material, leaving open only the question whether an omitted part is supplied by an equivalent device or instrumentality."

Fay v. Cordesman, 109 U. S. 408;

Shepard v. Carrigan, 116 U. S. 593, 597.

- (c) "A part which is made an essential element of a combination claim by the patentee must be given effect as a limitation, although unimportant in actual use. *Firestone Tire & Rubber Co. v. Seiberling*, 257 Fed. 74, C. C. A. 6."

Walker on Patents, Deller's Ed. 1259.

- (d) "The patentee makes all the parts of a combination material, when he claims them in combination and not separately. *Water-Meter Co. v. Desper*, 101 U. S. 332, (1880); *Brozen v. Davis*, 116 U. S. 237 (1886)."

Walker on Pats., Deller's Ed. 1697.

Law Point 7.

TO BE EQUIVALENT, A DEVICE MUST PERFORM THE SAME FUNCTION IN SUBSTANTIALLY THE SAME WAY.

- (a) "One thing, to be the equivalent of another, must perform the same function as that other. *Machine Co. v. Murphy*, 97 U. S. 120, 125 (1878); *Rowell v. Lindsay*, 113 U. S. 97, 103 (1885); *Roller Mill Patent*, 156 U. S. 261 (1895)."

Walker on Pats., Deller's Ed. 1704.

- (b) "The fact that one thing performs the same function as another, though necessary, is not sufficient to make it an equivalent thereof. *Eames v. Godfrey*, 1 Wallace (68 U. S.) 78 (1864); *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 537, 569 (1898)."

Walker on Pats., Deller's Ed. 1706.

- (c) "Function must be performed in substantially the same way by an alleged equivalent, as by the thing of which it is alleged to be an equivalent, in order to constitute it such. *Burr v. Duryee*, 1 Wall. (68 U. S.) 531, 573; *Fornecrook v. Root*, 127 U. S. 176, 181 (1888)."

Walker on Pats., Deller's Ed. 1706.

- (d) "But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine

cannot be patented is of no practical value. . . .
'That two machines produce the same effect will not justify the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other.'"

Boyden Power-Brake Co. v. Westinghouse, 170
U. S. 537, 568, 569.

- (e) "If an invention is only a trifling step forward and the claims speak plainly, they preclude resort to the doctrine of equivalents as regards alleged infringement. *Deitel v. Unique Specialty Corporation*, 54 F. (2d) 359, C. C. A. 2 (1931)."

Walker on Pats., Deller's Ed. 1240.

Law Point 8.

THE MATTER OF DERIVATION IS NOT MATERIAL TO THE
ISSUE OF INFRINGEMENT.

- (a) "Where a machine, article, or apparatus does not infringe, infringement cannot be predicated upon an intent to infringe, and it is immaterial whether the lack of infringement results from accident or deliberation."

48 *Corpus Juris* 294.

- (b) "Purpose and intent of an infringer are immaterial in determining the question of infringement. *Kansas City Southern Ry. Co. v. Silica Products Co.*, 48 F. (2d) 503, 508, C. C. A. 8 (1931), cert. den. 284 U. S. 626."

Walker on Pats., Deller's Ed. 1681.

Law Point 9.

UNLESS INVENTION IS PRESENT THE PATENT IS INVALID.

- (a) "Under the statute, (R. S. 4886) the device must not only be 'new and useful,' it must also be an 'invention' or 'discovery.' "

Cuno Eng. Corp. v. Automatic Devices Corp.,
314 U. S. 84, 90; 51 U. S. P. Q. 272, 275.

- (b) "Since *Hotchkiss v. Greenwood*, 11 How. 248, 267, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent, more ingenuity must be involved than the work of a mechanic skilled in the art."

R. G. LeTourneau, Inc. v. Gar Wood Industries, Inc., 151 F. (2d) 432; 67 U. S. P. Q. 165 (C. C. A. 9).

- (c) "In *Smith v. Nichols*, 88 U. S. 112, 119, the Court said:

'But a mere carrying forward or new and more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.'

. . . Accordingly, the flared construction is not such invention as will sustain a patent."

Wilson-Western Sporting Goods Co. v. Barnhart,
81 F. (2d) 108; 28 U. S. P. Q. 125 (C. C. A. 9).

- (d) “In the case of *Klein v. City of Seattle*, 77 Fed. 200, 204, this Court said:

‘A patent must combine utility, novelty, and invention. It may in fact embrace utility and novelty in a high degree, and still be only the result of mechanical skill as distinguished from invention. . . . It is not enough that a thing shall be new . . . and that it shall be useful, but it must under the Constitution and statute, amount to an invention or discovery.’

The principles stated in these decisions are well settled and require no further discussion.”

Keszthelyi v. Doheny Stone Drill Co., 59 F. (2d) 3; 13 U. S. P. Q. 427 (C. C. A. 9).

- (e) “In *Grinnel Machine Co. v. Johnson Co.*, 247 U. S. 426, 432, the Supreme Court stated:

‘No one by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices singly or in combination.’

All of the elements of the patent in suit were present in the prior art and combining these elements to make the patented device did not involve invention.”

Eagle, et al. v. P. & C. Hand Forged Tool Co., 74 F. (2d) 918; 24 U. S. P. Q. 181 (C. C. A. 9).

INDEX TO PAGES OF THE RECORD CONTAINING REMARKS
OF THE TRIAL COURT WHICH TEND TO THROW
SOME LIGHT ON THAT PORTION OF THE DECREE
HOLDING THE NEW FAWN GAME TO BE AN IN-
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